

PTO Form 1930 (Rev 9/2007)

OMB No. 0651-0050 (Exp. 4/30/2009)

## Request for Reconsideration after Final Action

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| <b>SERIAL NUMBER</b>   | 77351440       |
| <b>LAW OFFICE ASSIGNED</b>   | LAW OFFICE 110 |
| <b>MARK SECTION (no change)</b>  |                |
| <b>ARGUMENT(S)</b>   |                |
| <p><b><u>RESPONSE TO OFFICE ACTION AND</u></b><br/> <b><u>REQUEST FOR RECONSIDERATION AFTER FINAL ACTION</u></b><br/> <b><u>UNDER TMEP § 715.03</u></b></p> <p>The Official Letter dated July 27, 2009, has been received, and in response thereto, the above-entitled application is hereby amended.</p> <p>In view of the following amendment to the Identification of Goods/Services, the Applicant requests that the Examiner reconsider the prior findings and the finding of a "Final" rejection and appreciates reconsideration of its Application for Registration of the mark VARSITY TUTORS and design</p> <p style="text-align: center;"><b><u>AMENDMENTS AND REMARKS</u></b></p> <p><b><u>1. REQUEST FOR APPEAL</u></b></p> <p>In conjunction with the filing of this Response and Request for Reconsideration After Final Action, Applicant is also filing a Notice of Appeal to the Trademark Trial and Appeal Board, with payment of the appeal fee to provide that this application for Registration does not go abandoned.</p> <p><b><u>2. IDENTIFICATION OF GOODS/SERVICES</u></b></p> <p>The Applicant amends the identification of services as follows:</p> <p>"Education services, namely, <del>offering providing</del> directly to parents and students individualized <u>in-home tutoring services and subsequently providing such offered tutoring services on a one-to-one basis to individual students in the fields of math, chemistry, physics, biology, reading,</u> <del>writing,</del> economics, foreign languages, and university entrance and graduate level standardized tests."</p> |                |

Following these amendments, the amended description of the services is as follows:

"Education services, namely, offering directly to parents and students individualized in-home tutoring services and subsequently providing such offered tutoring services on a one-to-one basis to individual students in the fields of math, chemistry, physics, biology, economics, foreign languages, and university entrance and graduate level standardized tests."

The Applicant believes that the amendment to the identification of the services and the related new evidence as addressed below is consistent with the amendments to the identification of services that raise a new issue for consideration for Registration. As will also be addressed below, the Applicant believes that these will put the Application in condition for publication and for Registration.

The Applicant believes that this amended description of goods is clear and concise and descriptive and within the requirements of TMEP § 1402.01.

**3. THERE IS NO LIKELIHOOD OF CONFUSION OVER REGISTRATION NO.  
3399969**

The Registration of the proposed mark was refused in the Office action due to an initial finding of a likelihood of confusion with the mark "VARSITY COLLECTION" of U.S. Registration No. 3399969 (hereinafter the "Registration" and the "Registered Mark"). The Office action concluded there was a likelihood of confusion under the Du Pont factors due to the similarity of the marks and due to the similarity of goods. The Applicant traverses the refusal and the conclusions that there is a likelihood of confusion under consideration of all of the Du Pont factors in view of the mark in its entirety, and including the above noted change to the description of services.

Pursuant to *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), the issue of likelihood of confusion revolves around the similarity or dissimilarity of the marks and the relatedness of the goods or services. The following factors are typically included in determining likelihood of confusion:

- a. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
- b. The relatedness of the goods or services as described in an application or Registration or in connection with which a prior mark is in use.
- c. The similarity or dissimilarity of established, likely-to-continue trade channels.
- d. The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing.

Each of these factors will be addressed in view of the above amended description of services. However, it should be noted that the Federal Circuit Court determined that the critical issue in determining the likelihood of confusion was whether there is a likelihood of confusion as to the source of the goods and not whether the actual goods are likely to be confused. See *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993), and cases cited therein.

**3.a There Is No Similarity Between The Marks When Considering The Marks In Their Entirety As To Their Appearance, Sound, Connotation And Commercial Impression**

For the following reasons, when considering the Applicant's mark in its entirety in view of the

Registrant's mark in its entirety, there will be no confusion in the market or to any purchaser of goods or services.

3.a.1 Consumers Are Not Likely To Be Confused As The Common Element Of The Two Marks is Descriptive and Highly Suggestive

Where the common element of two marks is "weak" in that it is descriptive or highly suggestive of the named goods or services, consumers typically will be able to avoid confusion unless the overall combinations have other commonality. See, e.g., *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986) (BED & BREAKFAST REGISTRY for making lodging reservations for others in private homes held not likely to be confused with BED & BREAKFAST INTERNATIONAL for room booking agency services); *The U.S. Shoe Corp. v. Chapman*, 229 USPQ 74 (TTAB 1985) (COBBLER'S OUTLET for shoes held not likely to be confused with CALIFORNIA COBBLERS (stylized) for shoes); *In re Istituto Sieroterapico E' Vaccinogeno, Toscano "SCLAVO" S.p.A.*, 226 USPQ 1035 (TTAB 1985) (ASO QUANTUM (with "ASO" disclaimed) for diagnostic laboratory reagents held not likely to be confused with QUANTUM I for laboratory instrument for analyzing body fluids). In a sense the public can be said to rely more on the nondescriptive portions of each mark. Similarly, the Trademark Trial and Appeal Board and the courts have recognized that merely descriptive and weak designations may be entitled to a narrower scope of protection than an entirely arbitrary or coined word. *In re Central Soya Company, Inc.*, 220 USPQ 914 (TTAB 1984).

The Applicant's mark VARSITY TUTORS and design contains the word "varsity" in combination with the word "tutors," which has been disclaimed, along with a design and color scheme. The Registrant's mark VARSITY COLLECTION contains the same word "varsity" in combination with the word "collection," which has been disclaimed. The only common word between the two marks is the word "varsity."

Varsity is a commonly used descriptive term that pertains to an educational institution or school teams, activities, or competition. As shown in Attachment A in an extract from [www.dictionary.com](http://www.dictionary.com), the adjective "varsity" pertains to a university or school team, activity, or competition. It has an origin that dates back to 1840-50 related to a "versity university" from the 17th century. See Attachment A. As such, for more than 150 years, the term "varsity" is a term well-known and commonly used to define any and all nouns associated with a schools most senior or highest level of team, activity or competition and therefore has had a connotation with educational institutions for just as long.

As the Registrant's mark is for educational services and uses the historically commonly used educational word "varsity" as an adjective with regard to the disclaimed term "collection," the term "varsity" of the Registered Mark is not only descriptive but is also highly suggestive of the named goods or services. As such, under *In re Bed & Breakfast Registry*, consumers typically will be able to avoid confusion since the overall combinations of "varsity tutors" has no other commonality with the mark "varsity collection," other than the descriptive adjective term "varsity." Additionally, as the dominant portion of the Registrant's mark is the descriptive and highly suggestive word "varsity," under the holding of *In re Central Soya Company, Inc.*, the Registrant's mark is only entitled to a narrow scope of protection in consideration of likelihood of confusion. The dominant term "varsity" of the mark VARSITY COLLECTION, is a descriptive adjective and is highly suggestive, and therefore is a weak dominant term in the mark. As such, the DuPont balancing in favor of the Registration should be considered to be very low.

3.a.2 The Matter Common To The Marks Is Not Likely To Be Perceived By Purchasers as Distinguishing the Source as the Common Matter is Merely Descriptive

Similar to the above, marks have also been found not to have a likelihood of confusion where the matter common to the marks is not likely to be perceived by purchasers as distinguishing source due in part because it is merely descriptive or diluted. See, *In re S.D. Fabrics, Inc.*, 223 USPQ 54 (TTAB 1984) (DESIGNERS/FABRIC (stylized) for retail fabric store services held not likely to be confused with DAN RIVER DESIGNER FABRICS and design for textile fabrics).

As discussed above, the common word between the two marks, "varsity," is descriptive and highly suggestive of the named goods, and the other portion of the Registrant's mark "collection" and the other portion of the Applicant's mark "tutors" have each been disclaimed outside of their combination with the common descriptive and highly suggestive word "varsity." Where portions of the mark have been disclaimed, likelihood of confusion has been found to often not apply to the combination mark. For example, in *In re Farm Fresh Catfish Co.*, 231 USPQ 495 (TTAB 1986) the mark CATFISH BOBBERS had the word "CATFISH" disclaimed for fish, the court held that there was no likelihood of confusion with the mark BOBBER for restaurant services with the common word "bobbers." As this case illustrates, the common word "bobbers" outside of the use of the disclaimed term "catfish" was found not to be likely to create confusion with "BOBBERS" wherein the word "CATFISH" had been disclaimed.

Therefore, as the matter that is common to the marks, i.e., the word "varsity" is historically well known to relate to educational services and activities and therefore is generic and merely descriptive with regard to educational services. As such, the inclusion of the common descriptive term "varsity" in the Registration for educational services is not likely to be perceived by a purchaser as the sole distinguishing feature of the mark or as to the source of the Registrant's educational services for reading programs and for programs for assessing the level of difficulty of books as a part of a reading program.

### 3.a.3 The Applicants' Mark Should Be Compared On The Basis Of Visual Similarity As Its Primary And Dominate Feature Is The Stylized Design

As noted above, the Applicant's mark is a composite mark of the words "varsity" and "tutors" along with the design of the open book above the words. This also includes the specified color combinations. Taken in its entirety the Applicant's mark is a composite mark having a dominant and overriding feature of the stylized design of the words in combination with the open book design. This is in contrast with the Registrant's mark being the combination of the generic words "varsity" and "collection" without any design or further combination.

In considering the Applicant's overall mark as a composite mark having a dominant design feature, the rules for design marks can be considered. In addressing such, it has been determined that the similarity of a design mark should be decided primarily on the basis of visual similarity. See, e.g., *Red Carpet Corp. v. Johnstown American Enterprises Inc.*, 7 USPQ2d 1404 (TTAB 1988) (stylized house design for service of management of real estate properties for others held not likely to be confused with stylized house design for real estate brokerage services); and see *Ocean Spray Cranberries, Inc. v. Ocean Garden Products, Inc.*, 223 USPQ 1027 (TTAB 1984) (abstract circular design mark for seafood held not likely to be confused with oval breaking wave design for various food items including juices and fruits).

While the general rule is that the marks must be considered in their entireties, See *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 USPQ 272 (C.C.P.A. 1974), the Court of Appeals for the Federal Circuit has also cautioned, however, that "[t]here is no general rule as to whether letters or designs will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue." *In re Electrolyte Laboratories Inc.*, 929 F.2d 645, 647, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) (K+ and design for dietary potassium supplement held not likely to be confused with K-EFF (stylized) for dietary potassium supplement).

While it is not proper to dissect a mark, it has been found that where one feature of a mark is

more significant than another feature, greater weight may be given to the dominant feature for purposes of determining likelihood of confusion. See *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). Comparison of composite marks is done on a case-by-case basis without reliance on mechanical rules of construction. See, e.g., *Spice Islands, Inc. v. The Frank Tea & Spice Co.*, 505 F.2d 1293, 184 USPQ 35 (C.C.P.A. 1974) (SPICE TREE and tree design held not confusingly similar to SPICE ISLANDS and tree design, both for spices).

As addressed in the application for Registration for the Applicant's mark, the Applicants have clearly described the mark as having the literal element as "varsity tutors," having color, consisting of the words "varsity" and "tutors" with a stylized drawing of an open book above the center of the two words. "Varsity" is in navy blue and "Tutors" is in light blue. The left half of the drawing of the book is in light blue and the right half is in navy blue." The claimed colors are identified clearly in the application for Registration: "The color(s) navy blue and light blue is/are claimed as a feature of the mark." As such, the Applicant's mark is clearly a composite mark having a dominant feature including the design and color, and should be considered under the above line of cases. When considering the Applicant's mark as a composite mark, it is clear that there is no likelihood of confusion that will occur in the mark or with consumers, especially considering the different goods and services (as addressed below).

The Registrant's mark is two words, the word "varsity," which is highly descriptive and therefore should be given little weight or protection, in combination with the word "collection," which has been disclaimed and which is not common between the two marks. In contrast, the Applicant's mark is a composite mark that, on its face, includes a dominate feature of an open book in combination with the words, "varsity" and "tutors." The only common word is "varsity," which is descriptive of educational programs in general.

As the Registrant's mark does not include an open book in combination with the common and highly descriptive word "varsity," there can be little to no confusion to buyers or the market between the two marks.

#### 3.a.4 The Mark In Its Entirety Conveys A Significantly Different Commercial Impression

Similarly, since the Applicant's mark is for use with different services than the Applicant's mark as addressed above, even if the marks were to be considered to be similar as they both relate to educational services, albeit completely different educational services, a mark has also been found not to have a likelihood of confusion, even where the marks in their entireties convey significantly different commercial impressions. See, e.g., *In re Farm Fresh Catfish Co.*, 231 USPQ 495 (TTAB 1986) (CATFISH BOBBERS (with "CATFISH" disclaimed) for fish held not likely to be confused with BOBBER for restaurant services); *In re Shawnee Milling Co.*, 225 USPQ 747 (TTAB 1985) (GOLDEN CRUST for flour held not likely to be confused with ADOLPH'S GOLD'N CRUST and design (with "GOLD'N CRUST" disclaimed) for coating and seasoning for food items); *In re S.D. Fabrics, Inc.*, 223 USPQ 54 (TTAB 1984) (DESIGNERS/FABRIC (stylized) for retail fabric store services held not likely to be confused with DAN RIVER DESIGNER FABRICS and design for textile fabrics).

It has also been found that the style of lettering can be distinctly different so as to create a separate and independent impression. *In re Lytle Engineering & Mfg. Co.*, 125 USPQ 308 (TTAB 1960) ("LYTLE" is applied to the container for applicant's goods in a style of lettering distinctly different from the other portion of the trade name and is of such nature and prominence that it creates a separate and independent impression."). See Also *In re Univar Corp.*, 20 USPQ2d 1865, 1869 (TTAB 1991) ("The mark 'UNIVAR' independently projects a separate commercial impression, due to its presentation in a distinctively bolder, larger and different type of lettering and, in some instances, its additional use in a contrasting color, and thus does more than merely convey information about a corporate relationship.") See also *Book Craft, Inc. v. BookCrafters USA, Inc.*, 222 USPQ 724,

727 (TTAB 1984) ("That the invoices ... plainly show ... service mark use is apparent from the fact that, not only do the words 'BookCrafters, Inc.' appear in larger letters and a different style of print than the address, but they are accompanied by a design feature (the circularly enclosed ends of two books).").

The Applicant's composite mark VARSITY TUTORS and design is clearly different than the Registrant's mark "Varsity Collection." The dominant feature of the Applicant's mark is the combination of the words "tutors" and "varsity" along with the stylized design drawing of an open book above the center of the two words "varsity" and "tutors." The word "varsity" is on the left in navy blue and the word "tutors" is on the right in light blue. The left side of the stylized book that is above the words is in light blue and the right side of the stylized book is in navy blue, e.g., colors of the words and the two sides of the stylized drawing of an open book are opposite. As noted in the application for Registration of the present mark, the colors of light blue and navy blue are claimed as a feature of the mark. The impression of the Applicant's mark is clearly that of an open book along with the words "varsity" and "tutors."

As such, consistent with the above line of cases, the Applicant's mark VARSITY TUTORS and design, when taken in its entirety, and not improperly dissected provides a completely different impression to the market and to buyers than the impression of the Registrant's mark Varsity Collection. That mark gives the impression, not related to tutoring services or books, but generally to a collection associated with varsity level or related goods or goods or services classified for varsity use or application. Other than the common and highly descriptive term "varsity," there are no other commonalities that provide any common impression between the two marks.

As the Applicant's mark conveys an entirely and significantly different commercial impression than the commercial impression conveyed by the Registrant's stylized mark, the Applicant's mark is not likely to confuse purchasers as to the origin of the goods.

**3.b The Goods Are Sufficiently Dissimilar In Nature Even Though Both Are Related To Educational Services So As To Not Cause Confusion As They Are Not Each Common Educational Services**

The mark Varsity Collection is for services that are identified as educational services, namely a reading program for middle, high school and older students and a program for assessing the level of difficulty of books as part of a reading program. However, the Examiner has failed to consider that this listing of services in the Registration is limited to a reading program and a program for assessing the level of difficulty of books. These are not merely "common educational services" as suggested by the Office Action. See Office Action.

Contrary to the conclusions in the Office Action, as clearly limited in description of the services of the Registration, the registered mark Varsity Collection is for use with a reading program for students and a program for assessing the level of difficulty of books as a part of such reading program. This description is specifically for a services program for reading for students. While the description of the Registration is not clear as to what specifically a reading program is, the second recitation as to the assessment of books as to the difficulty of reading as a part of a reading program provides definition and limitation to scope of the Registration's recitation as to "reading program." The reading program as recited is a program for services of offering books that are assessed based on the difficulty and therefore the appropriateness of each book for the various levels of students. As such, the educational services of a reading program is a service of providing books that are assessed by level of student based on their determined difficulty of reading. This is not each merely "common educational services" but each recites a different specific type of educational service.

Secondly, and as a standalone service within the description for the Registration of the mark Varsity Collection also includes services in the form of a program for assessing the level of

difficulty of book as part of a reading program. This later recitation states that one of the two educational services within the Registration are services in a program for assessing books to determine their level of difficulty within or as part of a reading program. As the Registration states, this reading difficulty service program assesses that requires reviewing books and determining their level of difficulty for inclusion in a reading program. Again, this is not a common educational service but it a specific educational services, so specific in fact, as will be addressed below, that none of the 22 third-party Registrations as provided in the Office Action recite such a specific service.

As such, the Registration for the VARSITY COLLECTION mark is limited to two specific and limited types of educational services: one related to programs for evaluating the reading level of books and second to a program of providing reading program that contains pre-assessed difficulty of books to students such that the books in the program are applicable to the reading level within the reading program. However, the Examiner, in his attempt to provide a "broad interpretation" to the Registrant's description of services, failed to apply the limitations and restriction that are clearly reflected in the description of the services of the Registration. Failure to do so has resulted in the Examiner making improper conclusions such as "Each party provide common educational services. Thus, the services are highly related."

A correct consideration of the limitations and restrictions as recited in the Registration make it clear that the Registration is not for "common educational services" but for specific educational service programs for evaluating the reading level of books and offering or providing such assessed level books to students as a part of a reading program that is designed based on their level. For this reason alone, the request for reconsideration should be granted and an appropriate consideration of this likelihood of confusion factor should be reconsidered.

With regard to the numerous third-party Registrations attached to the Office action, the Applicant traverses these and the discussion relying on these as they, contrary to the Office action, do not provide any evidence or demonstration that many entities often produce the same kinds of goods as the registrant in this case, as well as, provide the same kinds of services as the applicant. The Applicant acknowledges that there are numerous entities that provide educational services. However, the Applicant's review of the 22 third-party Registrations as identified and attached to the Office Action failed to identify a single third-party Registration that describe any education service that is similar to those recited by the Registration. The Applicant does not believe that a single one of the cited 22 third-party Registrations includes educational services in either the form of a reading program or in the form of a program for assessing the level of difficulty of books as a part of a reading program.

From this, the Office action fails to describe, except in broad terms, that these third-party Registrations all provide the same kinds of common educational services as the Applicant as well as the same kinds of goods as the Registrant. As these third-party Registration do not include services as included in both the Registrant's and the Applicant's description of services, the 22 third-party Registrations provide absolutely no evidence that it common for providers of tutoring services, to also provide reading programs or programs for assessing the difficulty of books for a reading program as recited in the description of services of the Registration, as concluded in the Office Action. Therefore, none of the 22 third-party Registrations can be relied on for support of the refusal to register.

Further, the Applicant notes that, contrary to the conclusory and unsupported statements in the Office Action, the 22 third-party Registrations, illustrate that educational services is a broad general field, that requires providing a detailed listing of each specific educational service within the general educational services field. Each of the 22 third-party Registrations clearly recite within its listing of educational services, the inclusion of tutoring services, as well as the details of all of the other specific educational services. Additionally, each of these third-party Registrations list in detail each subject matter related to the use of the mark, e.g., whether reading, writing, mathematics, college entrance exams, basketball, or the like.

Each and every one of the 22 third-party Registrations provides an extensive listing of each

and every specific educational service. If such detailed listing of the specific educational services were meaningless, then there would be no requirement for such detailed listing. To the contrary, the details for the educational services are extremely important in broad educational services market. Therefore, the details are essential for considering the description of the educational services under a likelihood of confusion analysis. However, the Office action has failed to address this critical factor, but has broadly only viewed the Applicant's services and the listing of services in the Registration to be "common educational services."

To the contrary, it is clear that the Registration should not be read or interpreted as broadly as the Office action states as being "common educational services." Based on the provided 22 third-party Registrations, contrary to the Office action, there are no "common educational services" but only specific educational services as provided by the detail listings within the description of services of both the Registration and the Application. The Registration clearly lists educational services that are specific to reading, in the form of reading programs and assessing books for a reading program. Also, the Registration is owned by The American Reading Company. The Registrant's entire business is limited to educational services related to the subject matter of reading. See Attachments B-N.

In contrast, the description of services in the Application has been herein amended to add further limitations and restrictions with regard to the Applicant's services. This includes limiting the Application for Registration to educational tutoring services:

- a) by a channel of trade limited to being offered directly through parents and students;
- b) on an individualized basis, i.e., the tutoring is tailored to each student's needs;
- c) subsequently providing tutoring to each student in their own homes;
- d) on a one tutor to one student basis; and
- e) on subject matters or field limited to math, chemistry, physics, biology, economics, foreign languages, and university entrance and graduate level standardized tests.

The Applicant's amended description of services is for tutoring services in the fields of math, chemistry, physics, biology, economics, foreign languages, and university entrance and graduate level standardized tests. The Applicant's description of services, as amended, does not include tutoring for reading, providing a reading program, or a program for assessing the difficulty of reading of a book or the appropriateness of a book for the various grade-level reading program. As such, in contrast to the Registration, the Applicant's mark is for use with completely different educational services, which provide students with tutoring services for math, chemistry, physics, biology, economics, foreign languages, and university entrance and graduate level standardized tests. These are services wherein the student is aided in their education of these particular subject matters being taught in school or a review of the various subject matters and examination procedures and subjects as examined in standardized tests. This listing of services does not include a reading program and does not include a program or services that relate to the assessment of the difficulty of a reading book for a particular grade level of the student reader.

Therefore, while both the listing of services in the Registration and the amended Applicant are in the broad field of educational services, they are not related services and not merely "common educational services." Each mark is used for a different specific type of educational services and their descriptions are not otherwise related. As the amended description of services for the Applicant's mark VARSITY TUTORS and design is different and not similar in nature to the services of the Registrant's mark VARSITY COLLECTION, there will be no confusion in the market or to a purchaser.

**3.c The Channels Of Trade Are Dissimilar, The Conditions Under Which Sales Are Made Are Different, And The Buyers To Whom Sales Are Made Are Different**

As introduced above and included in the amended description of services, the Applicant's services are offered directly to the parents of student and students where the individual student is in



need of tutoring services in the subject matters of math, chemistry, physics, biology, economics, foreign languages, and university entrance and graduate level standardized tests. The Applicant's services are subsequently providing such offered tutoring services directly to the students on a one-on-one basis and in the student's home. As such, the buyers of the Applicant's services make a buying decision and associate the Applicant's mark with regard to the offering of supplemental one-on-one in-home teaching services related to one of math, chemistry, physics, biology, economics, foreign languages, and university entrance and graduate level standardized tests and its specific content.

It is recognized that the Registrant's listed services for educational services are not limited to the channels of trade or the customers as the description is silent in these regards. As such, it is difficult to evaluate and compare the channels of trade or conditions of sales. However, a review of the Registrant's website [www.americanreading.com](http://www.americanreading.com) (See Attachments B thru N) illustrates that its 100 Book Challenge includes its "Varsity Collection." These include Smart Start Classroom Modules that are clearly focused on sale to an educational institution for use on an entire class of up to 30 students. See Attachments B and N. Further, the pricing for each of these classroom modules: "Varsity Section Set," "Varsity Module (without incentives)," Varsity Module (grades 1-8)," and "Varsity Section Set (without incentives)," have a list price in English of \$1,800, \$3,300, \$3,500, and \$1,600, respectively, are not trivial costs. A further review of the Registrant's webpage illustrates that individual "Varsity Basket of Books" with up to 30 titles are sold for \$248, which appear to be for a reading program for a single student. *Id.*

As such, the reading program of the Registrant, while not limited in the description of services, is directed to educational administrators, teachers, librarians, etc. that require a pre-packaged reading program that has been pre-assessed for the targeted classroom of students. Such educational institution buyers of the Registrant's services (it is highly questionable as to whether the Registrant in fact sells or offers services under International Class 041 and across state lines, but in fact sell goods in the form of prepackage collection of books) would most likely be a sophisticated buyer for such a costly program. The buyers of the Registrant's "services" would exercise a relatively high degree of care before spending between \$1,600 and \$3,500 on a reading program of books for 30 students.

As cited in the Applicant's amended description of services, the Applicant offers it tutoring services directly to parents and students and only in the subjects of math, chemistry, physics, biology, economics, foreign languages, and university entrance and graduate level standardized tests, and does not seek Registration with regard to reading tutoring services. As such, by the amendment to the description of services in the Application, the services of the Applicant are offered directly to parents and students who are seeking one-on-one individualized tutoring services for the student. Each of these buyers will be making its purchase decision primarily on the particular tutor available for offering the one-on-one tutoring service. This buying decision is most often based on hiring the tutor that is best suited for the individual tutoring requirements of the particular student. As such, each buyer of the Applicant's services is focused and specific in its purchase decision based primarily on the specific individual providing the tutoring in their home and on a one-to-one basis.

As such, the channels of trade and buyers of the services of the Registrant for reading programs or programs for assessing the level of difficulty of books as a part of a reading program are completely different than those seeking in-home one-on-one individualized tutoring services as offered to parents and students by the Applicant and as subsequently provided to the student on a one-on-one basis in their home. As such, the buyers of the services of the Registrant and the Applicant are sufficiently different and the conditions for making purchases are different. Therefore, it is not likely that purchasers of the two services would be confused as to origin or source of the goods of the Applicant as compared to that of the Registrant.

**3.d. Summary of Du Pont Factors Indicates No Likelihood Of Confusion Between the Applicants Mark And The Registrant's Mark**

Based on a weighing of all these factors, it is clear that there is not a likelihood of confusion in the marketplace to a purchaser as to the origin or source of the goods. As such, the Section 2(d) rejection to register the Applicant's mark in view of the Registrant's mark should be withdrawn.

**3.e. The Use of the Registered Mark By Its Owner Appears to be Narrower Than Listed In Its Trademark Registration**

Finally, while it may not be conclusive on its own, the Applicant further reiterates that the owner of the mark "VARSITY COLLECTION," the American Reading Company, is not currently using the mark as is described in their trademark Registration description of goods and services. While the use of the mark in the Registration is for a reading program for middle, high school, and older students and a program for assessing the level of difficulty of books as part of a reading program, the American Reading Company's current website at <http://www.americanreading.com>, (See Attachments B-N) does not appear to use the Registered mark "VARSITY COLLECTION" currently on any of its on-line pages. While the adjective "varsity" is used often, the Applicant could not find a single use of the full registered mark on any of the Registrant's WebPages. Additionally, a Google search of the mark "Varsity Collection" with both "American reading" and separately "reading program" failed to identify any current use on the Internet by the Registrant of the Registered Mark.

The Applicant believes that this factor should also be weighed into the above analysis and the determination of likelihood of confusion and a finding that there is no likelihood of confusion between the two marks where the Registrant does not in fact use in interstate commerce the Registered Mark.

**4. THERE IS NO LIKELIHOOD OF CONFUSION OVER PENDING APPLICATION NO. 77255610**

The Office action states that there may be a likelihood of confusion between the present mark VARISTY TUTORS and the mark VARSITY SCHOLAR of pending Registration application No. 77255610, hereinafter the Registration. The Applicant traverses this preliminary rejection in anticipation of the potential Registration of application no. 77255610 as Applicant believes that there is no potential for confusion between the two pending marks.

**4.a There Is No Similarity Of Marks When Considering The Marks In Their Entirety As To Their Appearance, Sound, Connotation And Commercial Impression**

For the following reasons, when considering the Applicant's mark in its entirety in view of the Registrant's mark in its entirety, there will be no confusion in the market or to any purchaser of goods or services.

**4.a.1 Consumers Are Not Likely To Be Confused As The Common Element Of The Two Marks is Descriptive and Highly Suggestive**

As addressed above with regard to the VARSITY COLLECTION mark, where the common element of two marks is "weak" in that it is descriptive or highly suggestive of the named goods or services, consumers typically will be able to avoid confusion unless the overall combinations have other commonality.

The Applicant's mark VARSITY TUTORS and design contains the word "varsity" in combination with the word "tutors," which has been disclaimed, along with a design and color scheme. The Registration VARSITY SCHOLAR contains the same word "varsity" in combination with the word "scholar." The only common word between the two marks is the word "varsity."

As addressed above, the word "varsity" is a commonly used descriptive term that pertains to an educational institution. As the Registration is for "educational program promoting academic excellence among students" and uses the commonly used educational word "varsity," the term "varsity" is both descriptive and highly suggestive of the named goods or services of that mark. As such, consumers typically will be able to avoid confusion since the composite mark VARSITY TUTORS and design has no other commonality with the mark "VARSITY SCHOLAR." Additionally, as the entire Registration is merely descriptive and highly suggestive of services offered, the Registration, if ultimately maturing into a registered mark, would only be entitled to a narrow scope of protection in consideration of likelihood of confusion.

4.a.2 The Matter Common To The Marks Is Not Likely To Be Perceived By Purchasers as Distinguishing the Source as the Common Matter is Merely Descriptive

Similar to the above, the common word between the two marks, "varsity," is descriptive and highly suggestive of the named goods and services. That common word "varsity" is not likely to be perceived by a purchaser as distinguishing the source of services.

4.a.3 The Registrant's Mark Should Be Compared On The Basis Of Visual Similarity As Its Primary And Dominate Feature Is The Stylized Design

As noted above, the Applicant's mark is clearly a composite mark having a dominant feature including the design and color, and should be considered under the above line of cases. When considering the Applicant's mark as a composite mark, it is clear that there is no likelihood of confusion that will occur in the mark or with consumers in view of the Registration. The Registration is two words, the word "varsity," which alone is highly descriptive and therefore should be given little weight or protection, in combination with the word "scholars," which also alone is highly descriptive. The Registration in its entirety is also highly descriptive as it is a common term used in the educational field to describe student athletes and that mark is intended for users or buyers that are student athletes or varsity level scholars. In contrast, the Applicant's mark is a composite mark that, on its face, includes a dominate feature of an open book in combination with the words, "varsity" and "tutors." The only common word is "varsity," which is descriptive of educational programs in general.

As the Registration does not include an open book in combination with the common and highly descriptive word "varsity," there can be little to no confusion to buyers or the market between the two marks.

4.a.4 The Mark In Its Entirety Conveys A Significantly Different Commercial Impression

Similarly, the Applicant's mark conveys a significantly different commercial impression than the Registration. It has also been found that the style of lettering can be distinctly different so as to create a separate and independent impression. *In re Lytle Engineering & Mfg. Co.*, 125 USPQ 308 (TTAB 1960) ("‘LYTLE’ is applied to the container for applicant's goods in a style of lettering distinctly different from the other portion of the trade name and is of such nature and prominence that it creates a separate and independent impression."). *See Also In re Univar Corp.*, 20 USPQ2d 1865, 1869 (TTAB 1991) ("[T]he mark ‘UNIVAR’ independently projects a separate commercial impression, due to its presentation in a distinctively bolder, larger and different type of lettering and, in some instances, its additional use in a contrasting color, and thus does more than merely convey information about a corporate relationship.") *See also Book Craft, Inc. v. BookCrafters USA, Inc.*, 222 USPQ 724, 727 (TTAB 1984) ("That the invoices ... plainly show ... service mark use is apparent from the fact that, not only do the words ‘BookCrafters, Inc.’ appear in larger letters and a different style of print than the address, but they are accompanied by a design feature (the circularly enclosed ends of two books).").

The Applicant's composite mark VARSITY TUTORS and design is clearly different than the Registration. The dominant feature of the Applicant's mark is the combination of the words "tutors" and "varsity" along with the stylized design drawing of an open book above the center of the two words "varsity" and "tutors." The word "varsity" is on the left in navy blue and the word "tutors" is on the right in light blue. The left side of the stylized book that is above the words is in light blue and the right side of the stylized book is in navy blue, e.g., colors of the words and the two sides of the stylized drawing of an open book are opposite. As noted in the application for Registration of the present mark, the colors of light blue and navy blue are claimed as a feature of the mark. The impression of the Applicant's mark is clearly that of an open book along with the words "varsity" and "tutors."

As such, consistent with the above line of cases, the Applicant's mark VARSITY TUTORS and design, when taken in its entirety, and not improperly dissected provides a completely different impression to the market and to buyers than the impression of the Registration VARSITY SCHOLAR. The Registration gives the impression, not related to tutoring services or books, but generally to athletes that are also academic achievers, e.g., both an athlete and a scholar.

The Applicant's mark does not, in any way, provide an impression with regard to being a scholar or an academic achiever. Additionally, Applicant's mark does not, outside of the descriptive term "varsity," provide an impression with regard to an athlete. As such, other than the common and highly descriptive term "varsity," there are no other commonalities that provide any common impression between the two marks.

As the Applicant's mark conveys an entirely and significantly different commercial impression than the commercial impression conveyed by the Registration, the Applicant's mark is not likely to confuse purchasers as to the origin of the goods.

**4.e. The Applicant of *The* Registration Has Changed The Goods And Services and As A Result There Is Less Likelihood Of Confusion**

The Applicant would like to draw the Examiner's attention to the prosecution file of the mark "VARSITY SCHOLARS" and note that the applicant of *The* Registration amended their listing of goods and services in a May 30, 2008 Response to Office action. The new description of goods is: "Class 041 for Entertainment services, namely a continuing question and answer competition promoting academic excellence, presented live and by way of television, radio and the Internet; and educational services, namely, conducting programs in the field of academic excellence among students." The Examiner accepted this change of description in the Office action issued July 17, 2008.

The Applicant believes that this new description of goods for entertainment services and educational services of conducting programs is different than that of the Applicant. This in combination with the differences between the marks themselves would clearly lessen and diminish the likelihood of confusion between the Applicant's mark and *The* Registration.

**4.d. Summary of Du Pont Factors Indicates No Likelihood Of Confusion Between the Applicant's Mark And The Registrant's Mark**

Based on a weighing of all these factors, the Applicant's believe that there can be no confusion in the marketplace to a purchaser as to the origin or source of the Applicant's goods as compared to the Registration.

In summary, a review of the above Du Pont factors is now provided:

- a. the marks are dissimilar, and only have a single common term, Varsity, that term of which

is largely descriptive and generic as a standalone descriptive term that has historically referred to a level of educational institution programs;

b. the Applicant's amended services description for tutoring services does not include reading as one of the subject matters but is limited to the fields of math, chemistry, physics, biology, economics, foreign languages, and university entrance and graduate level standardized tests, and as such while both are within the very broad educational services classification, the Applicant's services are completely different than reading programs and book assessment programs of the Registrant;

c. the Applicant's amended services description limits the channels of trade and customers of the Applicant's mark to those offered directly to parents and students and subsequently provided to students on a one-on-one basis in their home for the recited subject matters, which is different than the channels of trade and the customer's of the educational institution reading programs as provided by the Registrant;

d. both the Applicant and the Registrant rely on direct marketing and selling of their different services, their different customers, and as such, there is little likelihood of confusion as to the origin of each of their services where direct marketing and selling is required for each sale; and

e. each of the purchaser's of the Applicant's tutoring services and the purchaser's of the Registrant's reading program services are focused on fulfilling a particular educational needs, albeit different needs, and therefore will exercise a high degree of care before making a purchasing decision for each of the services, as such, each will pay considerable attention to the source and, as such, there is no likelihood of any confusion.

As such, the balancing of these DuPont factors indicate that there is no likelihood of confusion in the marketplace to a purchaser of either the Registrant's services and the Applicant's services as to the origin or source of the goods or services. Therefore, in view of the above amendment to the identification of the services of that current Application and the above discussion with the attached Exhibits, the Section 2(d) refusal to register the Applicant's mark in view of the Registrant's mark should be withdrawn.

## **5. Summary**

First, it is believed that the significant amendment to the identification of the services raises a new issue and as such the Applicant request reconsideration of the prior "final" determination and reconsideration of the Applicant's Application and issue an new non-final action under TMEP 714.05 (a)(i).

Second, in view of the above amendments to the description of services, and the above discussion, the Applicant believes that all of the stated grounds of refusal for Registration rejection as identified in the current Office action have been properly traversed, accommodated, or rendered moot. The Applicant believes that this Response provides complies with all outstanding requirements and overcomes all outstanding refusals, and as such, the Applicant requests that the Examiner consider the above amendments for consideration of placing the application in condition for publication or Registration under TMEP 715.03(a). In the event that the Examiner does not agree, the Applicant requests that the Examiner issue an examiner's amendment to reduce the issues on appeal under TMEP 715.03(a) and TMEP 707.

In the alternative, the Applicant requests that the Examiner issue an Examiner's Action Continuing A Final Refusal to allow the Applicant additional time to resolve any outstanding matters under TMEP 718.03(b).

If the Examiner believes that personal communication will expedite prosecution of this Registration application, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

/David L. Howard/

**EVIDENCE SECTION****EVIDENCE FILE NAME(S)****ORIGINAL  
PDF FILE**

[http://tgate/PDF/RFR/2010/01/27/20100127173816320670-77351440-001\\_001/evi\\_6325212258-164942185\\_.\\_VARS\\_TMNDUS\\_Exhibits\\_A-N\\_evidence.pdf](http://tgate/PDF/RFR/2010/01/27/20100127173816320670-77351440-001_001/evi_6325212258-164942185_._VARS_TMNDUS_Exhibits_A-N_evidence.pdf)

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| <b>DESCRIPTION OF EVIDENCE FILE</b>   | Evidence in the nature of Exhibits A-N has been attached.       |
| <b>GOODS AND/OR SERVICES SECTION (current)</b>  |   |
| <b>INTERNATIONAL CLASS</b>  | 041   |
| <b>DESCRIPTION</b>  |   |
| Education services, namely, providing tutoring in the fields of math, chemistry, physics, biology, reading, writing, economics, foreign languages, and university entrance and graduate level standardized tests  |   |
| <b>FILING BASIS</b>   | Section 1(a)  |
| <b>FIRST USE ANYWHERE DATE</b>  | At least as early as 11/15/2007                                 |
| <b>FIRST USE IN COMMERCE DATE</b>   | At least as early as 12/01/2007                                 |
| <b>GOODS AND/OR SERVICES SECTION (proposed)</b>   |   |
| <b>INTERNATIONAL CLASS</b>  | 041   |
| <b>DESCRIPTION</b>  |   |
| Education services, namely, offering directly to parents and students individualized in-home tutoring services and subsequently providing such offered tutoring services on a one-to-one basis to individual students in the fields of math, chemistry, physics, biology, economics, foreign languages, and university entrance and graduate level standardized tests |   |
| <b>FILING BASIS</b>   | Section 1(a)  |
| <b>FIRST USE ANYWHERE DATE</b>  | At least as early as 11/15/2007                                 |
| <b>FIRST USE IN COMMERCE DATE</b>   | At least as early as 12/01/2007                                 |
| <b>SIGNATURE SECTION</b>  |   |
| <b>RESPONSE SIGNATURE</b>   | /David L. Howard/   |
| <b>SIGNATORY'S NAME</b>   | David L. Howard   |
| <b>SIGNATORY'S POSITION</b>   | Attorney for Applicant, MO bar member                           |
| <b>DATE SIGNED</b>  | 01/27/2010  |
| <b>AUTHORIZED SIGNATORY</b>   | YES   |

|                                |   |
|--------------------------------|---|
| CONCURRENT APPEAL NOTICE FILED | YES   |
| FILING INFORMATION SECTION     |   |
| SUBMIT DATE                    | Wed Jan 27 17:38:16 EST 2010  |
| TEAS STAMP                     | USPTO/RFR-63.252.122.58-2<br>0100127173816320670-77351<br>440-46011d0263f228fd5cf56<br>85f63ec924bdd-N/A-N/A-201<br>00127164942185278 |

PTO Form 1930 (Rev 9/2007)

OMB No. 0651-0050 (Exp. 4/30/2009)

**Request for Reconsideration after Final Action****To the Commissioner for Trademarks:**

Application serial no. **77351440** has been amended as follows:

**ARGUMENT(S)**

**In response to the substantive refusal(s), please note the following:**

**RESPONSE TO OFFICE ACTION AND**  
**REQUEST FOR RECONSIDERATION AFTER FINAL ACTION**  
**UNDER TMEP § 715.03**

The Official Letter dated July 27, 2009, has been received, and in response thereto, the above-entitled application is hereby amended.

In view of the following amendment to the Identification of Goods/Services, the Applicant requests that the Examiner reconsider the prior findings and the finding of a "Final" rejection and appreciates reconsideration of its Application for Registration of the mark VARSITY TUTORS and design

**AMENDMENTS AND REMARKS**

**1. REQUEST FOR APPEAL**

In conjunction with the filing of this Response and Request for Reconsideration After Final Action, Applicant is also filing a Notice of Appeal to the Trademark Trial and Appeal Board, with payment of the appeal fee to provide that this application for Registration does not go abandoned.

**2. IDENTIFICATION OF GOODS/SERVICES**



The Applicant amends the identification of services as follows:

"Education services, namely, ~~offering providing directly to parents and students individualized in-home tutoring services and subsequently providing such offered tutoring services on a one-to-one basis to individual students~~ in the fields of math, chemistry, physics, biology, ~~reading, writing,~~ economics, foreign languages, and university entrance and graduate level standardized tests."

Following these amendments, the amended description of the services is as follows:

"Education services, namely, offering directly to parents and students individualized in-home tutoring services and subsequently providing such offered tutoring services on a one-to-one basis to individual students in the fields of math, chemistry, physics, biology, economics, foreign languages, and university entrance and graduate level standardized tests."

The Applicant believes that the amendment to the identification of the services and the related new evidence as addressed below is consistent with the amendments to the identification of services that raise a new issue for consideration for Registration. As will also be addressed below, the Applicant believes that these will put the Application in condition for publication and for Registration.

The Applicant believes that this amended description of goods is clear and concise and descriptive and within the requirements of TMEP § 1402.01.

**3. THERE IS NO LIKELIHOOD OF CONFUSION OVER REGISTRATION NO.  
3399969**

The Registration of the proposed mark was refused in the Office action due to an initial finding of a likelihood of confusion with the mark "VARSITY COLLECTION" of U.S. Registration No. 3399969 (hereinafter the "Registration" and the "Registered Mark"). The Office action concluded there was a likelihood of confusion under the Du Pont factors due to the similarity of the marks and due to the similarity of goods. The Applicant traverses the refusal and the conclusions that there is a likelihood of confusion under consideration of all of the Du Pont factors in view of the mark in its entirety, and including the above noted change to the description of services.

Pursuant to *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), the issue of likelihood of confusion revolves around the similarity or dissimilarity of the marks and the relatedness of the goods or services. The following factors are typically included in determining likelihood of confusion:

- a. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
- b. The relatedness of the goods or services as described in an application or Registration or in connection with which a prior mark is in use.
- c. The similarity or dissimilarity of established, likely-to-continue trade channels.
- d. The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing.

Each of these factors will be addressed in view of the above amended description of services. However, it should be noted that the Federal Circuit Court determined that the critical issue in determining the likelihood of confusion was whether there is a likelihood of confusion as to the source of the goods and not whether the actual goods are likely to be confused. See *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993), and cases cited therein.

**3.a There Is No Similarity Between The Marks When Considering The Marks In Their Entirety As To Their Appearance, Sound, Connotation And Commercial Impression**

For the following reasons, when considering the Applicant's mark in its entirety in view of the Registrant's mark in its entirety, there will be no confusion in the market or to any purchaser of goods or services.

**3.a.1 Consumers Are Not Likely To Be Confused As The Common Element Of The Two Marks is Descriptive and Highly Suggestive**

Where the common element of two marks is "weak" in that it is descriptive or highly suggestive of the named goods or services, consumers typically will be able to avoid confusion unless the overall combinations have other commonality. See, e.g., *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986) (BED & BREAKFAST REGISTRY for making lodging reservations for others in private homes held not likely to be confused with BED & BREAKFAST INTERNATIONAL for room booking agency services); *The U.S. Shoe Corp. v. Chapman*, 229 USPQ 74 (TTAB 1985) (COBBLER'S OUTLET for shoes held not likely to be confused with CALIFORNIA COBBLERS (stylized) for shoes); *In re Istituto Sieroterapico E Vaccinogeno, Toscano "SCLAVO" S.p.A.*, 226 USPQ 1035 (TTAB 1985) (ASO QUANTUM (with "ASO" disclaimed) for diagnostic laboratory reagents held not likely to be confused with QUANTUM I for laboratory instrument for analyzing body fluids). In a sense the public can be said to rely more on the nondescriptive portions of each mark. Similarly, the Trademark Trial and Appeal Board and the courts have recognized that merely descriptive and weak designations may be entitled to a narrower scope of protection than an entirely arbitrary or coined word. *In re Central Soya Company, Inc.*, 220 USPQ 914 (TTAB 1984).

The Applicant's mark VARSITY TUTORS and design contains the word "varsity" in combination with the word "tutors," which has been disclaimed, along with a design and color scheme. The Registrant's mark VARSITY COLLECTION contains the same word "varsity" in combination with the word "collection," which has been disclaimed. The only common word between the two marks is the word "varsity."

Varsity is a commonly used descriptive term that pertains to an educational institution or school teams, activities, or competition. As shown in Attachment A in an extract from [www.dictionary.com](http://www.dictionary.com), the adjective "varsity" pertains to a university or school team, activity, or competition. It has an origin that dates back to 1840-50 related to a "versity university" from the 17th century. See Attachment A. As such, for more than 150 years, the term "varsity" is a term well-known and commonly used to define any and all nouns associated with a schools most senior or highest level of team, activity or competition and therefore has had a connotation with educational institutions for just as long.

As the Registrant's mark is for educational services and uses the historically commonly used educational word "varsity" as an adjective with regard to the disclaimed term "collection," the term "varsity" of the Registered Mark is not only descriptive but is also highly suggestive of the named goods or services. As such, under *In re Bed & Breakfast Registry*, consumers typically will be able to avoid confusion since the overall combinations of "varsity tutors" has no other commonality with the mark "varsity collection," other than the descriptive adjective term "varsity." Additionally, as the dominant portion of the Registrant's mark is the descriptive and highly suggestive word "varsity," under the holding of *In re Central Soya Company, Inc.*, the Registrant's mark is only entitled to a narrow scope of protection in consideration of likelihood of confusion. The dominant term "varsity" of the mark VARSITY COLLECTION, is a descriptive adjective and is highly suggestive, and therefore is a weak dominant term in the mark. As such, the DuPont balancing in favor of the Registration should be considered to be very low.

3.a.2 The Matter Common To The Marks Is Not Likely To Be Perceived By Purchasers as Distinguishing the Source as the Common Matter is Merely Descriptive

Similar to the above, marks have also been found not to have a likelihood of confusion where the matter common to the marks is not likely to be perceived by purchasers as distinguishing source due in part because it is merely descriptive or diluted. See, *In re S.D. Fabrics, Inc.*, 223 USPQ 54 (TTAB 1984) (DESIGNERS/FABRIC (stylized) for retail fabric store services held not likely to be confused with DAN RIVER DESIGNER FABRICS and design for textile fabrics).

As discussed above, the common word between the two marks, "varsity," is descriptive and highly suggestive of the named goods, and the other portion of the Registrant's mark "collection" and the other portion of the Applicant's mark "tutors" have each been disclaimed outside of their combination with the common descriptive and highly suggestive word "varsity." Where portions of the mark have been disclaimed, likelihood of confusion has been found to often not apply to the combination mark. For example, in *In re Farm Fresh Catfish Co.*, 231 USPQ 495 (TTAB 1986) the mark CATFISH BOBBERS had the word "CATFISH" disclaimed for fish, the court held that there was no likelihood of confusion with the mark BOBBER for restaurant services with the common word "bobbbers." As this case illustrates, the common word "bobbbers" outside of the use of the disclaimed term "catfish" was found not to be likely to create confusion with "BOBBERS" wherein the word "CATFISH" had been disclaimed.

Therefore, as the matter that is common to the marks, i.e., the word "varsity" is historically well known to relate to educational services and activities and therefore is generic and merely descriptive with regard to educational services. As such, the inclusion of the common descriptive term "varsity" in the Registration for educational services is not likely to be perceived by a purchaser as the sole distinguishing feature of the mark or as to the source of the Registrant's educational services for reading programs and for programs for assessing the level of difficulty of books as a part of a reading program.

3.a.3 The Applicants' Mark Should Be Compared On The Basis Of Visual Similarity As Its Primary And Dominate Feature Is The Stylized Design

As noted above, the Applicant's mark is a composite mark of the words "varsity" and "tutors" along with the design of the open book above the words. This also includes the specified color combinations. Taken in its entirety the Applicant's mark is a composite mark having a dominant and overriding feature of the stylized design of the words in combination with the open book design. This is in contrast with the Registrant's mark being the combination of the generic words "varsity" and "collection" without any design or further combination.

In considering the Applicant's overall mark as a composite mark having a dominant design feature, the rules for design marks can be considered. In addressing such, it has been determined that the similarity of a design mark should be decided primarily on the basis of visual similarity. See, e.g., *Red Carpet Corp. v. Johnstown American Enterprises Inc.*, 7 USPQ2d 1404 (TTAB 1988) (stylized house design for service of management of real estate properties for others held not likely to be confused with stylized house design for real estate brokerage services); and see *Ocean Spray Cranberries, Inc. v. Ocean Garden Products, Inc.*, 223 USPQ 1027 (TTAB 1984) (abstract circular design mark for seafood held not likely to be confused with oval breaking wave design for various food items including juices and fruits).

While the general rule is that the marks must be considered in their entireties, See *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 USPQ 272 (C.C.P.A. 1974), the Court of Appeals for the Federal Circuit has also cautioned, however, that "[t]here is no general rule as to whether letters or designs will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue." *In re Electrolyte Laboratories Inc.*, 929 F.2d 645, 647, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) (K+ and design for dietary potassium supplement held not likely to be confused with

K+EFF (stylized) for dietary potassium supplement).

While it is not proper to dissect a mark, it has been found that where one feature of a mark is more significant than another feature, greater weight may be given to the dominant feature for purposes of determining likelihood of confusion. See *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). Comparison of composite marks is done on a case-by-case basis without reliance on mechanical rules of construction. See, e.g., *Spice Islands, Inc. v. The Frank Tea & Spice Co.*, 505 F.2d 1293, 184 USPQ 35 (C.C.P.A. 1974) (SPICE TREE and tree design held not confusingly similar to SPICE ISLANDS and tree design, both for spices).

As addressed in the application for Registration for the Applicant's mark, the Applicants have clearly described the mark as having the literal element as "varsity tutors," having color, consisting of the words "varsity" and "tutors" with a stylized drawing of an open book above the center of the two words. "Varsity" is in navy blue and "Tutors" is in light blue. The left half of the drawing of the book is in light blue and the right half is in navy blue." The claimed colors are identified clearly in the application for Registration: "The color(s) navy blue and light blue is/are claimed as a feature of the mark." As such, the Applicant's mark is clearly a composite mark having a dominant feature including the design and color, and should be considered under the above line of cases. When considering the Applicant's mark as a composite mark, it is clear that there is no likelihood of confusion that will occur in the mark or with consumers, especially considering the different goods and services (as addressed below).

The Registrant's mark is two words, the word "varsity," which is highly descriptive and therefore should be given little weight or protection, in combination with the word "collection," which has been disclaimed and which is not common between the two marks. In contrast, the Applicant's mark is a composite mark that, on its face, includes a dominate feature of an open book in combination with the words, "varsity" and "tutors." The only common word is "varsity," which is descriptive of educational programs in general.

As the Registrant's mark does not include an open book in combination with the common and highly descriptive word "varsity," there can be little to no confusion to buyers or the market between the two marks.

### 3.a.4 The Mark In Its Entirety Conveys A Significantly Different Commercial Impression

Similarly, since the Applicant's mark is for use with different services than the Applicant's mark as addressed above, even if the marks were to be considered to be similar as they both relate to educational services, albeit completely different educational services, a mark has also been found not to have a likelihood of confusion, even where the marks in their entireties convey significantly different commercial impressions. See, e.g., *In re Farm Fresh Catfish Co.*, 231 USPQ 495 (TTAB 1986) (CATFISH BOBBERS (with "CATFISH" disclaimed) for fish held not likely to be confused with BOBBER for restaurant services); *In re Shawnee Milling Co.*, 225 USPQ 747 (TTAB 1985) (GOLDEN CRUST for flour held not likely to be confused with ADOLPH'S GOLD'N CRUST and design (with "GOLD'N CRUST" disclaimed) for coating and seasoning for food items); *In re S.D. Fabrics, Inc.*, 223 USPQ 54 (TTAB 1984) (DESIGNERS/FABRIC (stylized) for retail fabric store services held not likely to be confused with DAN RIVER DESIGNER FABRICS and design for textile fabrics).

It has also been found that the style of lettering can be distinctly different so as to create a separate and independent impression. *In re Lytle Engineering & Mfg. Co.*, 125 USPQ 308 (TTAB 1960) ("LYTLE" is applied to the container for applicant's goods in a style of lettering distinctly different from the other portion of the trade name and is of such nature and prominence that it creates a separate and independent impression."). See Also *In re Univar Corp.*, 20 USPQ2d 1865, 1869 (TTAB 1991) ("[T]he mark 'UNIVAR' independently projects a separate commercial impression, due to its presentation in a distinctively bolder, larger and different type of lettering and, in some instances, its additional use in a contrasting color, and thus does more than merely convey information about a corporate relationship.") See also *Book Craft, Inc. v. BookCrafters USA, Inc.*, 222 USPQ 724, 727

(TTAB 1984) ("That the invoices ... plainly show ... service mark use is apparent from the fact that, not only do the words 'BookCrafters, Inc.' appear in larger letters and a different style of print than the address, but they are accompanied by a design feature (the circularly enclosed ends of two books).").

The Applicant's composite mark VARSITY TUTORS and design is clearly different than the Registrant's mark "Varsity Collection." The dominant feature of the Applicant's mark is the combination of the words "tutors" and "varsity" along with the stylized design drawing of an open book above the center of the two words "varsity" and "tutors." The word "varsity" is on the left in navy blue and the word "tutors" is on the right in light blue. The left side of the stylized book that is above the words is in light blue and the right side of the stylized book is in navy blue, e.g., colors of the words and the two sides of the stylized drawing of an open book are opposite. As noted in the application for Registration of the present mark, the colors of light blue and navy blue are claimed as a feature of the mark. The impression of the Applicant's mark is clearly that of an open book along with the words "varsity" and "tutors."

As such, consistent with the above line of cases, the Applicant's mark VARSITY TUTORS and design, when taken in its entirety, and not improperly dissected provides a completely different impression to the market and to buyers than the impression of the Registrant's mark Varsity Collection. That mark gives the impression, not related to tutoring services or books, but generally to a collection associated with varsity level or related goods or goods or services classified for varsity use or application. Other than the common and highly descriptive term "varsity," there are no other commonalities that provide any common impression between the two marks.

As the Applicant's mark conveys an entirely and significantly different commercial impression than the commercial impression conveyed by the Registrant's stylized mark, the Applicant's mark is not likely to confuse purchasers as to the origin of the goods.

**3.b The Goods Are Sufficiently Dissimilar In Nature Even Though Both Are Related To Educational Services So As To Not Cause Confusion As They Are Not Each Common Educational Services**

The mark Varsity Collection is for services that are identified as educational services, namely a reading program for middle, high school and older students and a program for assessing the level of difficulty of books as part of a reading program. However, the Examiner has failed to consider that this listing of services in the Registration is limited to a reading program and a program for assessing the level of difficulty of books. These are not merely "common educational services" as suggested by the Office Action. See Office Action.

Contrary to the conclusions in the Office Action, as clearly limited in description of the services of the Registration, the registered mark Varsity Collection is for use with a reading program for students and a program for assessing the level of difficulty of books as a part of such reading program. This description is specifically for a services program for reading for students. While the description of the Registration is not clear as to what specifically a reading program is, the second recitation as to the assessment of books as to the difficulty of reading as a part of a reading program provides definition and limitation to scope of the Registration's recitation as to "reading program." The reading program as recited is a program for services of offering books that are assessed based on the difficulty and therefore the appropriateness of each book for the various levels of students. As such, the educational services of a reading program is a service of providing books that are assessed by level of student based on their determined difficulty of reading. This is not each merely "common educational services" but each recites a different specific type of educational service.

Secondly, and as a standalone service within the description for the Registration of the mark Varsity Collection also includes services in the form of a program for assessing the level of difficulty of book as part of a reading program. This later recitation states that one of the two educational services within the Registration are services in a program for assessing books to determine their level of difficulty within or as part of a reading program. As the Registration states, this reading

difficulty service program assesses that requires reviewing books and determining their level of difficulty for inclusion in a reading program. Again, this is not a common educational service but it a specific educational services, so specific in fact, as will be addressed below, that none of the 22 third-party Registrations as provided in the Office Action recite such a specific service.

As such, the Registration for the VARSITY COLLECTION mark is limited to two specific and limited types of educational services: one related to programs for evaluating the reading level of books and second to a program of providing reading program that contains pre-assessed difficulty of books to students such that the books in the program are applicable to the reading level within the reading program. However, the Examiner, in his attempt to provide a "broad interpretation" to the Registrant's description of services, failed to apply the limitations and restriction that are clearly reflected in the description of the services of the Registration. Failure to do so has resulted in the Examiner making improper conclusions such as "Each party provide common educational services. Thus, the services are highly related."

A correct consideration of the limitations and restrictions as recited in the Registration make it clear that the Registration is not for "common educational services" but for specific educational service programs for evaluating the reading level of books and offering or providing such assessed level books to students as a part of a reading program that is designed based on their level. For this reason alone, the request for reconsideration should be granted and an appropriate consideration of this likelihood of confusion factor should be reconsidered.

With regard to the numerous third-party Registrations attached to the Office action, the Applicant traverses these and the discussion relying on these as they, contrary to the Office action, do not provide any evidence or demonstration that many entities often produce the same kinds of goods as the registrant in this case, as well as, provide the same kinds of services as the applicant. The Applicant acknowledges that there are numerous entities that provide educational services. However, the Applicant's review of the 22 third-party Registrations as identified and attached to the Office Action failed to identify a single third-party Registration that describe any education service that is similar to those recited by the Registration. The Applicant does not believe that a single one of the cited 22 third-party Registrations includes educational services in either the form of a reading program or in the form of a program for assessing the level of difficulty of books as a part of a reading program.

From this, the Office action fails to describe, except in broad terms, that these third-party Registrations all provide the same kinds of common educational services as the Applicant as well as the same kinds of goods as the Registrant. As these third-party Registration do not include services as included in both the Registrant's and the Applicant's description of services, the 22 third-party Registrations provide absolutely no evidence that it common for providers of tutoring services, to also provide reading programs or programs for assessing the difficulty of books for a reading program as recited in the description of services of the Registration, as concluded in the Office Action. Therefore, none of the 22 third-party Registrations can be relied on for support of the refusal to register.

Further, the Applicant notes that, contrary to the conclusory and unsupported statements in the Office Action, the 22 third-party Registrations, illustrate that educational services is a broad general field, that requires providing a detailed listing of each specific educational service within the general educational services field. Each of the 22 third-party Registrations clearly recite within its listing of educational services, the inclusion of tutoring services, as well as the details of all of the other specific educational services. Additionally, each of these third-party Registrations list in detail each subject matter related to the use of the mark, e.g., whether reading, writing, mathematics, college entrance exams, basketball, or the like.

Each and every one of the 22 third-party Registrations provides an extensive listing of each and every specific educational service. If such detailed listing of the specific educational services were meaningless, then there would be no requirement for such detailed listing. To the contrary, the details for the educational services are extremely important in broad educational services market. Therefore, the details are essential for considering the description of the educational services under a likelihood of confusion analysis. However, the Office action has failed to address this critical factor, but has broadly

only viewed the Applicant's services and the listing of services in the Registration to be "common educational services."

To the contrary, it is clear that the Registration should not be read or interpreted as broadly as the Office action states as being "common educational services." Based on the provided 22 third-party Registrations, contrary to the Office action, there are no "common educational services" but only specific educational services as provided by the detail listings within the description of services of both the Registration and the Application. The Registration clearly lists educational services that are specific to reading, in the form of reading programs and assessing books for a reading program. Also, the Registration is owned by The American Reading Company. The Registrant's entire business is limited to educational services related to the subject matter of reading. See Attachments B-N.

In contrast, the description of services in the Application has been herein amended to add further limitations and restrictions with regard to the Applicant's services. This includes limiting the Application for Registration to educational tutoring services:

- a) by a channel of trade limited to being offered directly through parents and students;
- b) on an individualized basis, i.e., the tutoring is tailored to each student's needs;
- c) subsequently providing tutoring to each student in their own homes;
- d) on a one tutor to one student basis; and
- e) on subject matters or field limited to math, chemistry, physics, biology, economics, foreign languages, and university entrance and graduate level standardized tests.

The Applicant's amended description of services is for tutoring services in the fields of math, chemistry, physics, biology, economics, foreign languages, and university entrance and graduate level standardized tests. The Applicant's description of services, as amended, does not include tutoring for reading, providing a reading program, or a program for assessing the difficulty of reading of a book or the appropriateness of a book for the various grade-level reading program. As such, in contrast to the Registration, the Applicant's mark is for use with completely different educational services, which provide students with tutoring services for math, chemistry, physics, biology, economics, foreign languages, and university entrance and graduate level standardized tests. These are services wherein the student is aided in their education of these particular subject matters being taught in school or a review of the various subject matters and examination procedures and subjects as examined in standardized tests. This listing of services does not include a reading program and does not include a program or services that relate to the assessment of the difficulty of a reading book for a particular grade level of the student reader.

Therefore, while both the listing of services in the Registration and the amended Applicant are in the broad field of educational services, they are not related services and not merely "common educational services." Each mark is used for a different specific type of educational services and their descriptions are not otherwise related. As the amended description of services for the Applicant's mark VARSITY TUTORS and design is different and not similar in nature to the services of the Registrant's mark VARSITY COLLECTION, there will be no confusion in the market or to a purchaser.

### **3.c The Channels Of Trade Are Dissimilar, The Conditions Under Which Sales Are Made Are Different, And The Buyers To Whom Sales Are Made Are Different**

As introduced above and included in the amended description of services, the Applicant's services are offered directly to the parents of student and students where the individual student is in need of tutoring services in the subject matters of math, chemistry, physics, biology, economics, foreign languages, and university entrance and graduate level standardized tests. The Applicant's services are subsequently providing such offered tutoring services directly to the students on a one-on-one basis and in the student's home. As such, the buyers of the Applicant's services make a buying decision and associate the Applicant's mark with regard to the offering of supplemental one-on-one in-home teaching services related to one of math, chemistry, physics, biology, economics, foreign languages, and university entrance and graduate level standardized tests and its specific content.

It is recognized that the Registrant's listed services for educational services are not limited to the channels of trade or the customers as the description is silent in these regards. As such, it is difficult to evaluate and compare the channels of trade or conditions of sales. However, a review of the Registrant's website [www.americanreading.com](http://www.americanreading.com) (See Attachments B thru N) illustrates that its 100 Book Challenge includes its "Varsity Collection." These include Smart Start Classroom Modules that are clearly focused on sale to an educational institution for use on an entire class of up to 30 students. See Attachments B and N. Further, the pricing for each of these classroom modules: "Varsity Section Set," "Varsity Module (without incentives)," "Varsity Module (grades 1-8)," and "Varsity Section Set (without incentives)," have a list price in English of \$1,800, \$3,300, \$3,500, and \$1,600, respectively, are not trivial costs. A further review of the Registrant's webpage illustrates that individual "Varsity Basket of Books" with up to 30 titles are sold for \$248, which appear to be for a reading program for a single student. *Id.*

As such, the reading program of the Registrant, while not limited in the description of services, is directed to educational administrators, teachers, librarians, etc. that require a pre-packaged reading program that has been pre-assessed for the targeted classroom of students. Such educational institution buyers of the Registrant's services (it is highly questionable as to whether the Registrant in fact sells or offers services under International Class 041 and across state lines, but in fact sell goods in the form of prepackage collection of books) would most likely be a sophisticated buyer for such a costly program. The buyers of the Registrant's "services" would exercise a relatively high degree of care before spending between \$1,600 and \$3,500 on a reading program of books for 30 students.

As cited in the Applicant's amended description of services, the Applicant offers it tutoring services directly to parents and students and only in the subjects of math, chemistry, physics, biology, economics, foreign languages, and university entrance and graduate level standardized tests, and does not seek Registration with regard to reading tutoring services. As such, by the amendment to the description of services in the Application, the services of the Applicant are offered directly to parents and students who are seeking one-on-one individualized tutoring services for the student. Each of these buyers will be making its purchase decision primarily on the particular tutor available for offering the one-on-one tutoring service. This buying decision is most often based on hiring the tutor that is best suited for the individual tutoring requirements of the particular student. As such, each buyer of the Applicant's services is focused and specific in its purchase decision based primarily on the specific individual providing the tutoring in their home and on a one-to-one basis.

As such, the channels of trade and buyers of the services of the Registrant for reading programs or programs for assessing the level of difficulty of books as a part of a reading program are completely different than those seeking in-home one-on-one individualized tutoring services as offered to parents and students by the Applicant and as subsequently provided to the student on a one-on-one basis in their home. As such, the buyers of the services of the Registrant and the Applicant are sufficiently different and the conditions for making purchases are different. Therefore, it is not likely that purchasers of the two services would be confused as to origin or source of the goods of the Applicant as compared to that of the Registrant.

**3.d. Summary of Du Pont Factors Indicates No Likelihood Of Confusion Between the Applicants Mark And The Registrant's Mark**

Based on a weighing of all these factors, it is clear that there is not a likelihood of confusion in the marketplace to a purchaser as to the origin or source of the goods. As such, the Section 2(d) rejection to register the Applicant's mark in view of the Registrant's mark should be withdrawn.

**3.e. The Use of the Registered Mark By Its Owner Appears to be Narrower Than Listed In Its Trademark Registration**

Finally, while it may not be conclusive on its own, the Applicant further reiterates that the owner



of the mark "VARSITY COLLECTION," the American Reading Company, is not currently using the mark as is described in their trademark Registration description of goods and services. While the use of the mark in the Registration is for a reading program for middle, high school, and older students and a program for assessing the level of difficulty of books as part of a reading program, the American Reading Company's current website at <http://www.americanreading.com>, (See Attachments B-N) does not appear to use the Registered mark "VARSITY COLLECTION" currently on any of the its on-line pages. While the adjective "varsity" is used often, the Applicant could not find a single use of the full registered mark on any of the Registrant's WebPages. Additionally, a Google search of the mark "Varsity Collection" with both "American reading" and separately "reading program" failed to identify any current use on the Internet by the Registrant of the Registered Mark.

The Applicant believes that this factor should also be weighed into the above analysis and the determination of likelihood of confusion and a finding that there is no likelihood of confusion between the two marks where the Registrant does not in fact use in interstate commerce the Registered Mark.

**4. THERE IS NO LIKELIHOOD OF CONFUSION OVER PENDING APPLICATION NO. 77255610**

The Office action states that there may be a likelihood of confusion between the present mark VARISTY TUTORS and the mark VARSITY SCHOLAR of pending Registration application No. 77255610, hereinafter the Registration. The Applicant traverses this preliminary rejection in anticipation of the potential Registration of application no. 77255610 as Applicant believes that there is no potential for confusion between the two pending marks.

**4.a There Is No Similarity Of Marks When Considering The Marks In Their Entirety As To Their Appearance, Sound, Connotation And Commercial Impression**

For the following reasons, when considering the Applicant's mark in its entirety in view of the Registrants mark in its entirety, there will be no confusion in the market or to any purchaser of goods or services.

**4.a.1 Consumers Are Not Likely To Be Confused As The Common Element Of The Two Marks is Descriptive and Highly Suggestive**

As addressed above with regard to the VARSITY COLLECTION mark, where the common element of two marks is "weak" in that it is descriptive or highly suggestive of the named goods or services, consumers typically will be able to avoid confusion unless the overall combinations have other commonality.

The Applicant's mark VARSITY TUTORS and design contains the word "varsity" in combination with the word "tutors," which has been disclaimed, along with a design and color scheme. The Registration VARSITY SCHOLAR contains the same word "varsity" in combination with the word "scholar." The only common word between the two marks is the word "varsity."

As addressed above, the word "varsity" is a commonly used descriptive term that pertains to an educational institution. As the Registration is for "educational program promoting academic excellence among students" and uses the commonly used educational word "varsity," the term "varsity" is both descriptive and highly suggestive of the named goods or services of that mark. As such, consumers typically will be able to avoid confusion since the composite mark VARSITY TUTORS and design has no other commonality with the mark "VARSITY SCHOLAR." Additionally, as the entire Registration is merely descriptive and highly suggestive of services offered, the Registration, if ultimately maturing into a registered mark, would only be entitled to a narrow scope of protection in consideration of likelihood of confusion.

4.a.2 The Matter Common To The Marks Is Not Likely To Be Perceived By Purchasers as Distinguishing the Source as the Common Matter is Merely Descriptive

Similar to the above, the common word between the two marks, "varsity," is descriptive and highly suggestive of the named goods and services. That common word "varsity" is not likely to be perceived by a purchaser as distinguishing the source of services.

4.a.3 The Registrant's Mark Should Be Compared On The Basis Of Visual Similarity As Its Primary And Dominate Feature Is The Stylized Design

As noted above, the Applicant's mark is clearly a composite mark having a dominant feature including the design and color, and should be considered under the above line of cases. When considering the Applicant's mark as a composite mark, it is clear that there is no likelihood of confusion that will occur in the mark or with consumers in view of the Registration. The Registration is two words, the word "varsity," which alone is highly descriptive and therefore should be given little weight or protection, in combination with the word "scholars," which also alone is highly descriptive. The Registration in its entirety is also highly descriptive as it is a common term used in the educational field to describe student athletes and that mark is intended for users or buyers that are student athletes or varsity level scholars. In contrast, the Applicant's mark is a composite mark that, on its face, includes a dominate feature of an open book in combination with the words, "varsity" and "tutors." The only common word is "varsity," which is descriptive of educational programs in general.

As the Registration does not include an open book in combination with the common and highly descriptive word "varsity," there can be little to no confusion to buyers or the market between the two marks.

4.a.4 The Mark In Its Entirety Conveys A Significantly Different Commercial Impression

Similarly, the Applicant's mark conveys a significantly different commercial impression than the Registration. It has also been found that the style of lettering can be distinctly different so as to create a separate and independent impression. *In re Lytle Engineering & Mfg. Co.*, 125 USPQ 308 (TTAB 1960) ("LYTLE' is applied to the container for applicant's goods in a style of lettering distinctly different from the other portion of the trade name and is of such nature and prominence that it creates a separate and independent impression."). *See Also In re Univar Corp.*, 20 USPQ2d 1865, 1869 (TTAB 1991) ("[T]he mark 'UNIVAR' independently projects a separate commercial impression, due to its presentation in a distinctively bolder, larger and different type of lettering and, in some instances, its additional use in a contrasting color, and thus does more than merely convey information about a corporate relationship.") *See also Book Craft, Inc. v. BookCrafters USA, Inc.*, 222 USPQ 724, 727 (TTAB 1984) ("That the invoices ... plainly show ... service mark use is apparent from the fact that, not only do the words 'BookCrafters, Inc.' appear in larger letters and a different style of print than the address, but they are accompanied by a design feature (the circularly enclosed ends of two books).").

The Applicant's composite mark VARSITY TUTORS and design is clearly different than the Registration. The dominant feature of the Applicant's mark is the combination of the words "tutors" and "varsity" along with the stylized design drawing of an open book above the center of the two words "varsity" and "tutors." The word "varsity" is on the left in navy blue and the word "tutors" is on the right in light blue. The left side of the stylized book that is above the words is in light blue and the right side of the stylized book is in navy blue, e.g., colors of the words and the two sides of the stylized drawing of an open book are opposite. As noted in the application for Registration of the present mark, the colors of light blue and navy blue are claimed as a feature of the mark. The impression of the Applicant's mark is clearly that of an open book along with the words "varsity" and "tutors."

As such, consistent with the above line of cases, the Applicant's mark VARSITY TUTORS and design, when taken in its entirety, and not improperly dissected provides a completely different

impression to the market and to buyers than the impression of the Registration VARSITY SCHOLAR. The Registration gives the impression, not related to tutoring services or books, but generally to athletes that are also academic achievers, e.g., both an athlete and a scholar.

The Applicants mark does not, in any way, provide an impression with regard to being a scholar or an academic achiever. Additionally, Applicant's mark does not, outside of the descriptive term "varsity," provide an impression with regard to an athlete. As such, other than the common and highly descriptive term "varsity," there are no other commonalities that provide any common impression between the two marks.

As the Applicant's mark conveys an entirely and significantly different commercial impression than the commercial impression conveyed by the Registration, the Applicant's mark is not likely to confuse purchasers as to the origin of the goods.

**4.e. The Applicant of *The Registration* Has Changed The Goods And Services and As A Result There Is Less Likelihood Of Confusion**

The Applicant would like to draw the Examiner's attention to the prosecution file of the mark "VARSITY SCHOLARS" and note that the applicant of *The Registration* amended their listing of goods and services in a May 30, 2008 Response to Office action. The new description of goods is: "Class 041 for Entertainment services, namely a continuing question and answer competition promoting academic excellence, presented live and by way of television, radio and the Internet; and educational services, namely, conducting programs in the field of academic excellence among students." The Examiner accepted this change of description in the Office action issued July 17, 2008.

The Applicant believes that this new description of goods for entertainment services and educational services of conducting programs is different than that of the Applicant. This in combination with the differences between the marks themselves would clearly lessen and diminish the likelihood of confusion between the Applicant's mark and *The Registration*.

**4.d. Summary of Du Pont Factors Indicates No Likelihood Of Confusion Between the Applicants Mark And The Registrant's Mark**

Based on a weighing of all these factors, the Applicant's believe that there can be no confusion in the marketplace to a purchaser as to the origin or source of the Applicant's goods as compared to the Registration.

In summary, a review of the above Du Pont factors is now provided:

- a. the marks are dissimilar, and only have a single common term, Varsity, that term of which is largely descriptive and generic as a standalone descriptive term that has historically referred to a level of educational institution programs;
- b. the Applicant's amended services description for tutoring services does not include reading as one of the subject matters but is limited to the fields of math, chemistry, physics, biology, economics, foreign languages, and university entrance and graduate level standardized tests, and as such while both are within the very broad educational services classification, the Applicant's services are completely different than reading programs and book assessment programs of the Registrant;
- c. the Applicant's amended services description limits the channels of trade and customers of the Applicant's mark to those offered directly to parents and students and subsequently provided to students on a one-on-one basis in their home for the recited subject matters, which is different than the channels of trade and the customer's of the educational institution reading programs as provided by the Registrant;
- d. both the Applicant and the Registrant rely on direct marketing and selling of their different services, their different customers, and as such, there is little likelihood of confusion as to the origin of each of their services where direct marketing and selling is required for each sale; and

e. each of the purchaser's of the Applicant's tutoring services and the purchaser's of the Registrants reading program services are focused on fulfilling a particular educational needs, albeit different needs, and therefore will exercise a high degree of care before making a purchasing decision for each of the services, as such, each will pay considerable attention to the source and, as such, there is no likelihood of any confusion.

As such, the balancing of these DuPont factors indicate that there is no likelihood of confusion in the marketplace to a purchaser of either the Registrant's services and the Applicant's services as to the origin or source of the goods or services. Therefore, in view of the above amendment to the identification of the services of that current Application and the above discussion with the attached Exhibits, the Section 2(d) refusal to register the Applicant's mark in view of the Registrant's mark should be withdrawn.

## **5. Summary**

First, it is believed that the significant amendment to the identification of the services raises a new issue and as such the Applicant request reconsideration of the prior "final" determination and reconsideration of the Applicant's Application and issue an new non-final action under TMEP 714.05(a) (i).

Second, in view of the above amendments to the description of services, and the above discussion, the Applicant believes that all of the stated grounds of refusal for Registration rejection as identified in the current Office action have been properly traversed, accommodated, or rendered moot. The Applicant believes that this Response provides complies with all outstanding requirements and overcomes all outstanding refusals, and as such, the Applicant requests that the Examiner consider the above amendments for consideration of placing the application in condition for publication or Registration under TMEP 715.03(a). In the event that the Examiner does not agree, the Applicant requests that the Examiner issue an examiner's amendment to reduce the issues on appeal under TMEP 715.03(a) and TMEP 707.

In the alternative, the Applicant requests that the Examiner issue an Examiner's Action Continuing A Final Refusal to allow the Applicant additional time to resolve any outstanding matters under TMEP 718.03(b).

If the Examiner believes that personal communication will expedite prosecution of this Registration application, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

/David L. Howard/

## **EVIDENCE**

Evidence in the nature of Evidence in the nature of Exhibits A-N has been attached. has been attached.

### **Original PDF file:**

[http://tgate/PDF/RFR/2010/01/27/20100127173816320670-77351440-001\\_001/evi\\_6325212258-164942185\\_VARS\\_TMNDUS\\_Exhibits\\_A-N\\_evidence.pdf](http://tgate/PDF/RFR/2010/01/27/20100127173816320670-77351440-001_001/evi_6325212258-164942185_VARS_TMNDUS_Exhibits_A-N_evidence.pdf)

### **Converted PDF file(s) (17 pages)**

Evidence-1

Evidence-2

Evidence-3  
Evidence-4  
Evidence-5  
Evidence-6  
Evidence-7  
Evidence-8  
Evidence-9  
Evidence-10  
Evidence-11  
Evidence-12  
Evidence-13  
Evidence-14  
Evidence-15  
Evidence-16  
Evidence-17

#### **CLASSIFICATION AND LISTING OF GOODS/SERVICES**

**Applicant proposes to amend the following class of goods/services in the application:**

**Current:** Class 041 for Education services, namely, providing tutoring in the fields of math, chemistry, physics, biology, reading, writing, economics, foreign languages, and university entrance and graduate level standardized tests

Original Filing Basis:

**Filing Basis: Section 1(a), Use in Commerce:** The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 11/15/2007 and first used in commerce at least as early as 12/01/2007, and is now in use in such commerce.

**Proposed:** Class 041 for Education services, namely, offering directly to parents and students individualized in-home tutoring services and subsequently providing such offered tutoring services on a one-to-one basis to individual students in the fields of math, chemistry, physics, biology, economics, foreign languages, and university entrance and graduate level standardized tests

**Filing Basis: Section 1(a), Use in Commerce:** The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 11/15/2007 and first used in commerce at least as early as 12/01/2007, and is now in use in such commerce.

#### **SIGNATURE(S)**

##### **Request for Reconsideration Signature**

Signature: /David L. Howard/ Date: 01/27/2010

Signatory's Name: David L. Howard

Signatory's Position: Attorney for Applicant, MO bar member

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the

applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 77351440

Internet Transmission Date: Wed Jan 27 17:38:16 EST 2010

TEAS Stamp: USPTO/RFR-63.252.122.58-2010012717381632

0670-77351440-46011d0263f228fd5cf5685f63

ec924bdd-N/A-N/A-20100127164942185278

A. H. H. H. H. A

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varsity

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## Related Searches

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## Nearby Words

varro  
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## varsity - 3 dictionary results

## Varsity at Amazon

Find everything for the office. From address books to desk lamps.  
[Amazon.com/office](http://Amazon.com/office)

**var-si-ty** (vahr-si-tee) [2] [Show IPA](#) *noun, plural -ties, adjective*

## Use varsity in a Sentence

## -noun

1. any first-string team, esp. in sports, that represents a school, college, university, or the like: *He is on the varsity in tennis and in debating.*
2. *Chiefly British Informal.* **UNIVERSITY.**

## -adjective

3. of or pertaining to a university or school team, activity, or competition: *a varsity debater.*

## Origin:

1840-50; cf. *varsity* university, in 17th century; prob. prob. preserves historical outcome of ME *var*, as in *VARMINT*

Dictionary.com Unabridged  
 Based on the Random House Dictionary, © Random House, Inc. 2010  
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## Related Words for : varsity

first team

View more related words »

## VISUAL THESAURUS

Explore the Visual Thesaurus »

## Varsity at Amazon

Find everything for the office. From address books to desk lamps.  
[Amazon.com/office](http://Amazon.com/office)

**var-si-ty** (vahr-si-tee) [2]  
*n. pl. var-si-ties*

1. The principal team representing a university, college, or school in sports, games, or other competitions.
2. *Chiefly British* A university.

[Shortening and alteration of **university**.]

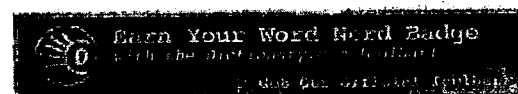
The American Heritage® Dictionary of the English Language, Fourth Edition  
 Copyright © 2009 by Houghton Mifflin Company.  
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[Cite This Source](#)

## Word Origin &amp; History

## varsity

1846, "university," variant of earlier *varsity* (1680), shortened form of *university*.

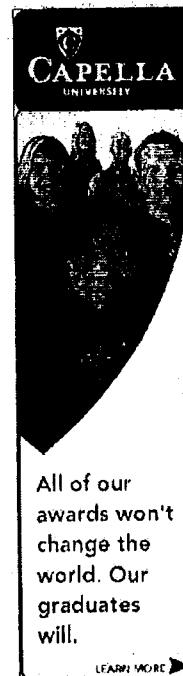
Online Etymology Dictionary, © 2001 Douglas Harper  
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Search another word or see **varsity** on Thesaurus | Reference

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- Confusing Words
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- Literary terms



## 100 Book Challenge® Varsity

## National Standards for Reading

American Benchmarks for Excellence™ is ARC's standards-based leveling system.

[Learn more »](#)

## 100 Book Challenge® for Grades PreK-9

- PreK
- Kindergarten
- Benchmark (Grades 1-5)
- Varsity (Grades 5-9)

## Get Every Student to Proficient or Advanced on State Tests

100 Book Challenge Varsity is designed to accelerate achievement for middle school students with reading levels, 1st through 12th grades. With our standards-based leveling system, advanced students are never bored by the pace, while remedial students receive the support they need to catch up. The Varsity Smart Start module includes all books, educator tools, and student materials to create, support and promote a reading culture in middle school classrooms.

## Also Recommended

- Explorer Express
- Summer School Express

Smart Start Module    Smart Start Section Sets    Express Module

## Varsity Smart Start Classroom Module

For up to 30 students, 5 classroom minimum

## Teacher Resource Kit

## Reading Skills Cards (165)

## KidPace 3.0

Data Collection & Analysis Tool

## Logbooks (30)

## Milestone Awards (30)

30 each of 100-400 Steps

## Incentive Kit

Prizes for first 200 Steps

## Drawstring Bags (30)

## Incentive Reading Folders (165)

## Classroom Library

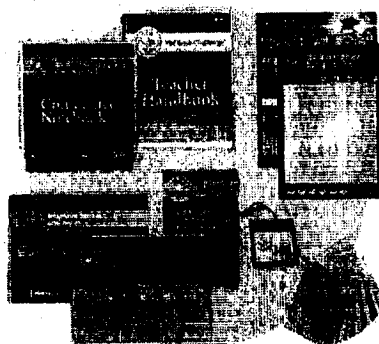
10 Baskets/250-300 multicultural titles

## Start-Up Workshop

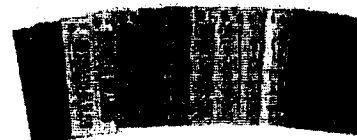
1 full day of professional development training included for 5-20 purchased modules

**\$3,500.00**

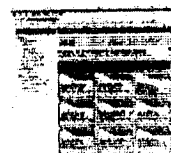
for 30 students



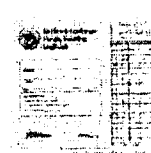
Teacher Resource Kit



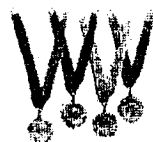
Reading Skills Cards (165)



KidPace 3.0



Logbooks (30)



Milestone Awards (30)



Incentive Kit



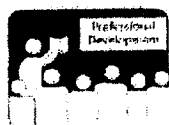
Drawstring Bags (30)



Incentive Reading Folders (165)



Classroom Library





*A. H. Hunt C*

## Professional Development

### Professional Development

- [Overview](#)
- [Action 100](#)
- [100 Book Challenge](#)
- [Research Labs](#)

### Partner for Success

Master teachers, principals, and superintendents lead all sessions.

Professional development staff have been selected because of their demonstrated ability to increase student achievement using American Reading Company programs.

Professional development action plans are customized to fit your school or district improvement model.

Your success is our success.

### Embedded In Our Programs

American Reading Company professional development is embedded in each of our programs. This essential partnership builds teacher and administrator capacity and helps ensure success for all stakeholders.

#### Action 100

##### RTI Accountability Model

Action 100 is American Reading Company's most comprehensive intervention program with a 12-step professional development initiative to ensure the success of all schools and student sub-groups. Teacher and administrator learning is front loaded early and often so that Action 100 is fully and effectively implemented from the first day of school.

[Learn more »](#)

#### 100 Book Challenge

##### Get Every Student to Proficient in Reading

100 Book Challenge begins with a comprehensive, interactive, hands-on introduction to the program. Where possible, we include in-class demonstrations with your students. Support continues with several types of teacher coaching visits, each focusing on a different, important aspect of program implementation.

[Learn more »](#)

#### Research Labs

##### Project-Based Learning + Reading and Writing in Content Areas

Professional Development for Research Labs teaches teachers and administrators how to use the full range of thematic materials to turn each classroom into an active learning laboratory. Participants learn how to use extensive nonfiction, thematic book collections and support material to conduct thematic investigations that build students' vocabulary, background knowledge, and skills in reading, writing, researching, and publishing.

[Learn more »](#)

*A. Hachant D*

## Our Mission

### Mission:

*To ensure every student is reading on or above grade level.*

### Core Value:

*Our strength is in our diversity.*

American Reading Company is setting a new standard for reading achievement in the classroom and in the home. We are helping improve reading scores for schools and school districts. We are helping to improve self-esteem and confidence of young aspiring readers and providing tools and resources to help teachers and administrators succeed.

Created by teachers, curriculum specialists, and literacy activists, American Reading Company's systematic approach to fostering independent reading is turnkey, intuitive, and proven.

### Contact Us

Call or e-mail American Reading Company today.

#### E-mail

[info@americanreading.com](mailto:info@americanreading.com)

#### Toll-free

1-866-810-BOOK (2665)

#### Phone

610-992-4150

#### Fax

610-992-4156

#### Address

201 S. Gulph Rd.  
King of Prussia, PA 19406  
[Map & Directions](#)

*A. Hileman E*

## Our History

The 100 Book Challenge reading program was first used in a suburban Philadelphia school district where Jane Hileman, CEO and founder of American Reading Company, was working as a reading specialist. Ms. Hileman challenged a group of second graders with kindergarten-level reading abilities to read 100 books.

The kids read hundreds of books while Ms. Hileman and her colleagues used daily conferencing and assessment sessions to coach individuals and ensure the shared curriculum met the needs of all the students. Parents were coached on how to establish the home routines essential to long-term academic success.

By giving them the choice to read books leveled to their abilities, 100 Book Challenge enabled students to experience success with reading and encouraged them to read more. Ms. Hileman also offered them inexpensive prizes as incentives for reading a certain number of books. Even the most reluctant of students got hooked on reading through Ms. Hileman's 100 Book Challenge, and soon, all the second graders had improved their reading scores.

Word about 100 Book Challenge spread, and Ms. Hileman was invited to bring the program into Philadelphia city schools, where her ideas for reading improvement were put to use in several of the district's poorest schools. When two of the schools were recognized nationally for doubling the percentage of students reading on or above grade level, 100 Book Challenge was cited as one of the reasons behind the schools' successes.

Ms. Hileman was then invited to become the co-founder and associate director of PHILADELPHIA READS. With the support of the William Penn Foundation, 100 Book Challenge spread to more than 70 Philadelphia schools. In 1998, the Abell Foundation of Baltimore asked Ms. Hileman to provide her program to 10 Baltimore city schools. To fulfill that order, Ms. Hileman decided to establish 100 Book Challenge as a business.

Customer-financed from the beginning, American Reading Company has grown in terms of revenue, customers, staffing, and types of programs offered since it was founded. The company's core program, 100 Book Challenge, is currently used in more than 420 districts in 40 states, plus the District of Columbia. More than 285,000 students participate in the program nationwide. To reflect its national customer-base and its growing list of products and programs, the company changed its name from 100 Book Challenge to American Reading Company in 2004.

American Reading Company's rapid growth and success in the classroom has not gone unnoticed. In October 2004, the company was named one of the top 100 fastest-growing private firms in the Philadelphia area by the Philadelphia Business Journal, the Entrepreneurs' Forum of Greater Philadelphia, and the Wharton Small Business Development Center. In March 2005, Random House, Inc., through its Random House Ventures, L.L.C. investment subsidiary, became a leading minority shareholder in American Reading Company.

More than 100 people from a wide variety of backgrounds work for American Reading Company in King of Prussia, Pennsylvania. Former educators, customers, vendors, and parents are on staff to help develop programs, provide support, and offer training to the schools that implement American Reading Company programs.

## Contact Us

Call or e-mail American Reading Company today.

**E-mail**  
[info@americanreading.com](mailto:info@americanreading.com)

**Toll-free**  
 1-866-810-BOOK (2665)

**Phone**  
 610-992-4150

**Fax**  
 610-992-4156

**Address**  
 201 S. Gulph Rd.  
 King of Prussia, PA 19406  
[Map & Directions](#)

**American Benchmarks for Excellence™**

*Click a level to view details.*

*Attachment F***IRLA: Independent Reading Level Assessment\***

The IRLA provides comprehensive details about each reading level in the ABE leveling system.

[Learn more »](#)

**National Standards for Reading**

The American Benchmarks for Excellence (ABE) Leveling System maps out the reading field for both books and readers, integrating national standards for reading acquisition with a deep knowledge of the demands of instructional and trade literature for children, grades K through 12. The ABE color-coded system is grounded on a review of more than 75,000 books—books evaluated with the following three questions in mind:

- What does the reader need to know and be able to do to understand this book?
- What supports does the text offer an independent thinker and problem solver?
- What challenges does this text present to a reader who is comfortable with other texts at this same basic level?

The ABE Leveling System is multi-dimensional, evaluating each book and reader on the following:

1. [Reading as Independent Thinking and Problem Solving](#)
2. [Phonics](#)
3. [Sight Words](#)
4. [Literary Vocabulary](#)
5. [Background Knowledge](#)
6. [Language Issues](#)
7. [Book Presentation](#)

These factors shift in importance as a student moves through the ABE color levels, but their significance at any level is always based on the question of what a reader needs to know to be successful at a particular color level. Because the ABE Leveling System locates a reader in relation to national grade-level standards, and because the leveling system is transparent, it provides direction for teachers, parents, and students on what a student needs to learn and practice to move ahead in reading proficiency.

The ABE System has been successfully field-tested in more than 1,800 schools across the country with hundreds of thousands of readers, making it possible for students to easily find books they can enjoy and read successfully, books that allow them to improve their reading through reading.

**IRLA**

A more comprehensive delineation of the ABE Leveling System can be found in the [Independent Reading Level Assessment \(IRLA\)](#). The IRLA details the standards-based learning that is expected at each reading level, providing a critical tool for on-going, formative assessment of student reading. It allows teachers to accurately identify each student's current placement on a PreK through 12 reading continuum, determining what the student knows and what the student needs to learn next.

To view details about each level in the ABE Leveling System, [click here »](#)

**Alignment to Other Systems**

The ABE levels correlate to levels of other commonly used leveling systems. [Click here](#) for details.

*Attachment 6*

Click a button to see 100 Book Challenge® for your grade.

## 100 Book Challenge®

### 60 Minutes of Daily Reading Practice

Students read 30 minutes in school and 30 minutes at home. Quantity practice targets are set, monitored, and rewarded, ensuring every student adopts the independent reading routines of academically successful students.

### Every Student Working at Appropriate Level

Using national standards for reading proficiency, both books and students are leveled based on what readers need to know and be able to do at each of the five developmental stages of reading acquisition, as outlined by No Child Left Behind.

[Learn more about how our leveling system compares to other leveling systems.](#)

### Connects Your Reading Initiatives to State Standards

100 Book Challenge aligns all of your existing reading materials and assessment tools using one simple color-coded leveling platform, keyed to your state standards, that students, teachers, and parents can understand and use to ensure every student is making expected progress towards proficiency.

### Includes Parent Partnership Routines

As if they had stopped at the book store on the way home from school every day with \$15-\$50 to spend, each student arrives home every afternoon with 1 or 2 or 3 or more, trade books, hot off the press, that are part of a system designed for their achievement. The standards-based book sizing system and take home Skills Cards keep parents informed and participating in their children's success.

*A. H. Schmitt H*

**Content Studies**

**Grade-level  
Standards**

**Student-level  
Access**

**Research Labs**  
Project-Based Learning in  
Science and Social Studies  
[Learn more »](#)

**Theme & Genre Modules**  
More than 50 Thematic Text  
Sets  
[Learn more »](#)

**Available Themes & Levels**

More than 50 thematic units are  
available for grades ranging from  
kindergarten through 12th grade.

[Browse the full list »](#)

**Choose from 58 Themes**



Medieval  
Civilizations



Age of Exploration



Holocaust



The Arts



Native Americans



Colonial American  
Era

**Use Leveled Thematic Text Sets to Engage Every Student**

- Teach nonfiction reading using balanced, trade book collections.
- Teach grade-level content standards.
- Differentiate instruction across reading levels.

**Grade-level Standards, Student-Level Access**

Our Thematic Text Sets provide a comprehensive collection of interesting, multi-cultural, grade appropriate books for all reading levels. Using these relevant books aligned to your curriculum, educators can teach grade-level social studies and standards and use differentiated instruction to teach reading at the same time.

## Summer School Express



## Reading Intervention and Project-Based Learning in Science or Social Studies

**Summer School Themes**

See the list of themes available for Summer School Express. [Click here.](#)

**Also Recommended**

- [Explorer Express](#) for After School and Extended Day
- [100 Book Challenge](#)
- [Research Labs](#)

**National Standards for Reading**

American Benchmarks for Excellence™ is ARC's standards-based leveling system. [Learn more »](#)

### Everything you need to engage students, increase teacher capacity, and raise test scores.

Summer School Express is a standards-based reading intervention built around project-based learning in the content areas. Best practices in literacy are packed into 4 weeks of learning for everyone. Differentiated reading intervention for every level of achievement is built in.

### Summer School Express includes Reading Intervention and Theme Content Study for \$1,850

**Reading Intervention**

- Explicit, differentiated instruction
- Tier II vocabulary development
- 25 hours of reading practice
- Standards-based assessment

**Summer School Express Module****Theme Content Study**

- Research-focused reading and writing
- Tier III vocabulary development
- Project-based learning
- Content standards specific to your state



[Download the Summer School Express brochure.](#)

**Reading Intervention****Milestone Awards (30)**

15 100-Step & 15 200-Step Medals

**Reading Skills Cards (250-340)****IRLA****Logbooks (15)**

Elementary or Varsity

**Conference Notebook****Teacher Handbook****5 Baskets/100 Titles****Summer School Express Training**

1 full day of professional development training included for 5-20 purchased modules



Milestone Awards (30)



Reading Skills Cards (250-340)



IRLA



Logbooks (15)



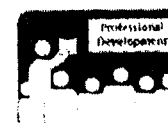
Conference Notebook



Teacher Handbook



5 Baskets/100 Titles



Summer School Express Training

**Theme Content Study****Teacher Pacing Guide****Research Cards (30)****Geography Map Cards****Writing Cards (120)**

**Blackline Masters for Student Research**

Final Project Organizers

**Theme-Related Folders**

**Project Blank Books (30)**

**Summer School Express Training**

1 full day of professional development training included for 5-20 purchased modules

**Theme Content Study Library**

5 Baskets/100 Titles



Teacher Pacing Guide



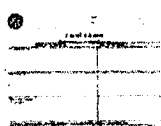
Research Cards (30)



Geography Map Cards



Writing Cards (120)



Blackline Masters for Student Research



Theme-Related Folders



Project Blank Books (30)



Summer School Express Training



Theme Content Study Library



*Attachment J*



**HOME**

**KidPace 3**

[Features](#)

[System Requirements](#)

[Help & Documentation](#)

**Book Database**

[Features](#)

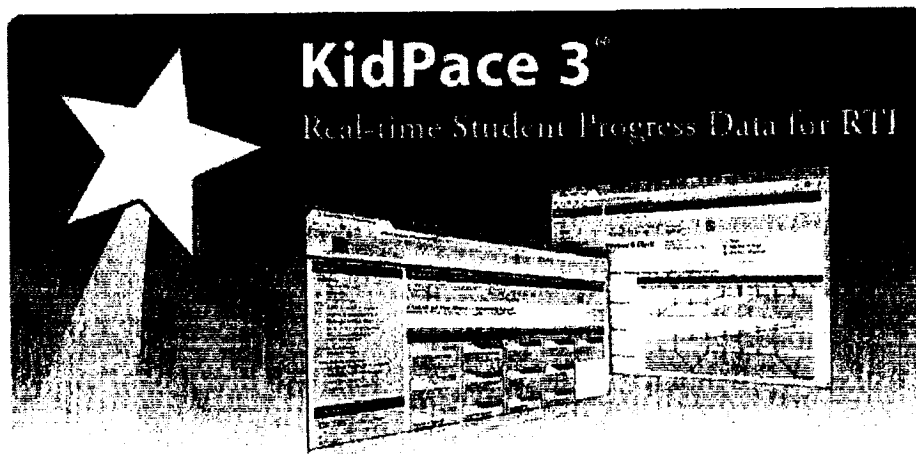
[System Requirements](#)

[Help & Documentation](#)

**Customer Support**

[How to Buy](#)

[Contact Customer Support](#)



**LOGIN**

Username

Password

## How many of your students are reading on grade level today?

With KidPace 3, teachers and administrators can monitor real-time student progress data on the web. KidPace 3 provides easy-to-use charts and graphs that tell you exactly which students are reading on grade level, and which students are getting enough reading practice. Student progress is automatically aggregated by classroom, school, district, and subgroup to provide the data you need to drive instruction.

## How does reading level affect student results on state tests?

Upgrade to KidPace 3 Pro to be able to create customized district data sets and collect data for state tests, core instructional programs, or any other student progress data.

You can import information from most student data collection systems, and export to popular reporting and analysis tools, including Excel.

[Learn More](#)

[Features](#)

[System Requirements](#)

[How to Buy](#)



[View Printer-Friendly Page](#)

For best results, make sure to print in landscape mode. If any on-screen graphics fail to print, enable the printing of background colors and images (usually found in your web browser's Page Setup dialog).

A. Hachant K

## Solutions by Curriculum Design

### Independent Reading

- 100 Book Challenge
- Explorer Express for Extended Day
- Summer School Express

### Informational Text Sets

- Research Labs
- Thematic & Genre Modules
- Explorer Express for Extended Day
- Summer School Express

### Project-Based Learning

- Research Labs
- Explorer Express for Extended Day
- Summer School Express

### Thematic Inquiry

- Research Labs
- Thematic & Genre Modules
- Explorer Express for Extended Day
- Summer School Express

### Integrated Curriculum

- Research Labs

Attachment L

## Solutions by Grade

### PreK

- 100 Book Challenge PreK

### Kindergarten

- 100 Book Challenge Kindergarten
- Zoology One
- Thematic Text Sets

### Elementary

- 100 Book Challenge Benchmark
- Thematic Text Sets
- Research Labs
- Zoology One
- Explorer Express for Extended Day
- Summer School Express

### Middle School

- 100 Book Challenge Varsity
- Thematic Text Sets
- Research Labs
- Explorer Express for Extended Day
- Summer School Express

### Extended Day

- Explorer Express for Extended Day

### Summer School

- Summer School Express

*Attachment M*

## Ordering Information

### Print or Download our Price List

Our price list provides the prices for American Reading Company products, including classroom modules, professional development workshops, software, and à la carte items such as individual baskets and replacement books.

[Click here](#) to view the price list.

### Ordering Assistance

For ordering assistance or to place an order, please call us toll-free at **1-866-810-2665** or [locate your sales rep.](#)

[Download the Unpacking Instructions](#)

### Contact Us

Call or e-mail American Reading Company today.

**E-mail**  
[info@americanreading.com](mailto:info@americanreading.com)

**Toll-free**  
1-866-810-BOOK (2665)

**Phone**  
610-992-4150

**Fax**  
610-992-4156

**Address**  
201 S. Gulph Rd.  
King of Prussia, PA 19406  
[Map & Directions](#)

*A. H. Hunt*



## Price List

For ordering assistance or to place an order, contact an American Reading Company representative at 1-866-810-BOOK (2665).

- Prices are effective August 1, 2009.
- Prices are subject to change.
- Shipping is free within the continental United States.
- Classroom modules require a minimum purchase of 5 modules.

### Contact ARC

**Toll-free**  
1-866-810-BOOK (2665)

**Fax**  
610-992-4156

**Address**  
201 S. Gulph Rd.  
King of Prussia, PA 19406

**Online**  
www.americanreading.com

## 100 Book Challenge®

### Smart Start Classroom Modules

- Minimum 5 modules
- Free shipping within the continental United States
- For 30 Students

| Item                                     | English | Spanish |
|--|---------|---------|
| PreK Module                              | \$2,000 | \$2,200 |
| Kindergarten Module                      | \$3,000 | \$3,200 |
| Benchmark Module (grades 1-8)            | \$3,500 | \$3,700 |
| Benchmark Module (without incentives)    | \$3,300 | \$3,500 |
| Varsity Module (grades 5-12)             | \$3,500 | —       |
| Varsity Section Set                      | \$1,800 | —       |
| Varsity Module (without incentives)      | \$3,300 | —       |
| Varsity Section Set (without incentives) | \$1,600 | —       |
| Scholars Module (grades 9-12)            | \$3,300 | —       |
| Scholars Section Set                     | \$1,600 | —       |
| Reorder Module (without PD) (no min.)    | \$700   | \$900   |
| Reorder Module (with PD)                 | \$1,000 | \$1,200 |

### Dual Language Express Module

- Free shipping within the continental United States
- For 15 students

| Item                         | Price   |
|------------------------------|---------|
| Dual Language Express Module | \$2,400 |

### Basket Materials

- Free shipping within the continental United States

| Item                                    | Price   |
|---|---------|
| Basket Label                            | \$1.00  |
| Color Levelling Tape<br>(roll of 1,000) | \$61.00 |
| Empty Basket                            | \$4.00  |

### Individual Baskets & Classroom Libraries

- Free shipping within the continental United States
- Indicate which color/reading level for each basket ordered.

| Item  | English | Spanish |
|---|---------|---------|
| Benchmark Basket of Books<br>(30 titles YY-Pu; 25 Titles Br-SI) | \$248   | \$264   |
| Varsity Basket of Books<br>(30 titles YY-Pu; 25 Titles Br-SI)   | \$248   | —       |
| Theme Baskets of Books<br>(25 titles)                           | \$248   | \$264   |
| Replacement Book  | \$10    | \$11    |
| Readings Single Level Individual Title                          | \$7.50  | \$7.50  |
| Classroom Library: 5 Baskets                                    | \$1,240 | \$1,320 |
| Classroom Library: 8 Baskets                                    | \$1,984 | \$2,112 |
| Classroom Library: 10 Baskets                                   | \$2,480 | \$2,640 |

### Reading Skills Cards

- Free shipping within the continental United States

| Item  | Price   |
|---|---------|
| Skills Cards (15) any single English or Spanish | \$3.50  |
| Skills Cards: Conference (15)                   | \$3.50  |
| Skills Cards: Classroom Set                     | \$66.00 |
| Skills Cards: Special Education Classroom Set   | \$33.00 |
| Skills Cards: Phonics Classroom Set             | \$27.00 |
| Skills Cards: Laminated Ring English            | \$33.00 |
| Skills Cards: Laminated Ring Spanish            | \$33.00 |

**100 Book Challenge®****Program Materials for Students**

- Free shipping within the continental United States
- For all Milestone Awards and Folders please indicate which Step for each pack of 15 ordered.

| Item   | Price    |
|--|----------|
| Incentive Kit  | \$242.00 |
| Milestone Awards Dog Tags (15)   | \$17.00  |
| Milestone Awards Dog Tags Classroom Set (120)<br>30 each 100-400 Steps | \$132.00 |
| Milestone Award Medals (15)  | \$28.00  |
| Milestone Award Medals Classroom Set (120)<br>30 each 100-400 Steps    | \$220.00 |
| Milestone Wristbands (15)  | \$17.00  |
| Milestone Wristbands Classroom Set (120),<br>30 each 100-400 Steps     | \$132.00 |
| Reading Incentive Folders (15)   | \$9.00   |
| Reading Incentive Folders (165)  | \$99.00  |
| Take-Home Book Bag   | \$4.00   |
| Drawstring Bag   | \$4.00   |
| Portfolio (15)   | \$17.00  |
| Log book: 500-Book Kid   | \$3.00   |
| Logbook: Elementary  | \$4.00   |
| Logbook: Varsity A, B, or W  | \$3.00   |

**Program Materials for Teachers, Coaches, and Principals**

- Free shipping within the continental United States

| Item  | Price    |
|---|----------|
| Benchmark Assessment Kit  | \$275.00 |
| 100 Book Challenge® Baseball Jersey                               | \$39.00  |
| Principal's Kit   | \$165.00 |
| Principal's Reading Champion Certificates                         | \$9.50   |
| "I Read with the Principal today" adhesive pad<br>(pack of 5)     | \$22.00  |
| Principal's Reading Champion Poster                               | \$3.00   |
| Principal's Classroom Door Banner                                 | \$17.00  |
| Classroom Reading Poster<br>(pack of 10)                          | \$28.00  |
| On-Target Badge   | \$8.00   |
| Teacher Resource Kit (TRK)  | \$110.00 |
| Dual Language TRK   | \$110.00 |
| Teacher Express Kit   | \$88.00  |
| Teacher Conference Notebook                                       | \$39.00  |
| IRLA: Independent Reading Level Assessment®                       | \$39.00  |
| ENIL (Spanish IRLA)   | \$44.00  |
| "I read with the Reading Coach today" adhesive pad<br>(pack of 5) | \$22.00  |
| Site Coordinator Kit  | \$165.00 |
| Canvas Site Coordinator Bag                                       | \$17.00  |

**ARC Theme Core Studies****Text Sets, Research Labs® (RL), Curriculum Integration Project (CIP) & Explorer Express Modules**

- Free shipping within the continental United States
- Minimum 5 modules

| Item  | English | Spanish |
|---|---------|---------|
| Mini Text Set<br>(2 theme baskets, 50 titles)             | \$500   | \$530   |
| Express Text Set<br>(4 theme baskets, 100 titles)         | \$975   | \$1,000 |
| Smart Start Theme Module<br>(6 theme baskets, 150 titles) | \$1,450 | \$1,550 |
| Smart Start Research Labs                                 | \$2,200 | \$2,300 |
| Smart Start CIP   | \$2,700 | —       |
| Research Labs Express                                     | \$1,400 | \$1,500 |
| Research Labs Section Set                                 | \$100   | \$100   |
| Explorer Express  | \$2,500 | \$2,700 |
| RL, CIP, or Explorer Section Set                          | \$200   | \$200   |

**Kindergarten Modules**

- Free shipping within the continental United States
- Minimum 5 modules

| Item                        | English | Spanish |
|-----------------------------|---------|---------|
| Zoology One                 | \$3,300 | \$3,500 |
| Zoology One Transition Pack | \$1,300 | \$1,400 |

**Research Labs (RL) & Curriculum Integration Project (CIP) Materials**

- Free shipping within the continental United States

| Item  | English  | Spanish  |
|---|----------|----------|
| Reference Library (15 titles)                 | \$198.00 | \$209.00 |
| Theme Folders                                 | \$20.00  | —        |
| Research Cards (15)                           | \$3.50   | —        |
| Research Cards<br>(Pack of 90)                | \$20.00  | —        |
| Essential Question Card (15)                  | \$3.50   | —        |
| Writing Cards (60)<br>15 of 4 different cards | \$13.50  | —        |
| Project Blank Book                            | \$4.50   | —        |

**Professional Development****Workshops**

- Maximum per Session: 20 Participants

| Item  | Price   |
|---|---------|
| Smart Start Professional Development Module                         | \$8,500 |
| Reorder Professional Development Module                             | \$6,500 |
| Start-Up Workshop   | \$3,100 |
| Individual On-Site Teacher Support Visit<br>(max. 10 classrooms)    | \$2,100 |
| Fishbowl On-Site Teacher Support Visit<br>(max. 5 classrooms)       | \$2,100 |
| Any Advanced Level Workshop   | \$3,100 |
| Family or Student Workshop  | \$1,600 |
| Individual Per Teacher Training<br>(attending an existing training) | \$350   |
| Individual Per Teacher at ARC Headquarters                          | \$350   |

**Computer Program Materials****Web-Based Software**

| Item                                | Price   |
|-------------------------------------|---------|
| KidPace® 3.0 1-year license         | \$1,000 |
| KidPace® 3.0 Pro 1-year license     | \$2,000 |
| Online Book Database 1-year license | \$500   |